CERTIFICATE

Supreme Court of the United States

OCTOBER TERM, [redacted] 1926

No. [redacted]285

OVERLAND MOTOR COMPANY

vs.

PACKARD MOTOR CAR COMPANY AND WIRE WHEEL CORPORATION OF AMERICA

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

FILED JANUARY 20, 1926

(31,655)

(31,655)

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1925

No. 932

OVERLAND MOTOR COMPANY

vs.

PACKARD MOTOR CAR COMPANY AND WIRE WHEEL CORPORATION OF AMERICA

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., FEBRUARY 16, 1926

[fol. 1]

IN UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

3439

OVERLAND MOTOR COMPANY

vs.

PACKARD MOTOR CAR COMPANY and WIRE WHEEL CORPORATION OF AMERICA

Appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division

ORDER TO TRANSMIT QUESTIONS OF LAW—January 22, 1926

It is ordered by the court that the clerk of this court be, and is hereby directed to transmit to the Supreme Court of the United States certain questions of law, which are in the following words and figures, to wit:

[fol. 2] [Title omitted]

STATEMENT OF FACTS

On this appeal certain questions of law have arisen, concerning which this Court is in doubt, and desires the advice of the Supreme Court.

The relevant facts out of which the legal questions grow are:

1. The suit is one wherein appellee sought to enjoin an alleged infringement of the Cowles patent, No. 1,103,567, issued July 14, 1914.

2. Cowles, previously, on August 25, 1899, filed an application for a patent which was duly granted, July 13, 1900. In this application he disclosed the subject matter in suit. The Patent Office, however, required a division of claims, and Cowles canceled all claims as well as the description and drawings in the specification that supported such claims bearing upon the subject matter of the present con-

troversy. The patent that was granted covered merely the remaining claims.

3. On September 6, 1901, Cowles filed another application, but not a divisional application, disclosing and claim-
[fol. 3] ing, among other things, the subject matter in suit, and this application was pending in the Patent Office until January 21, 1913, when a patent issued therein.

Certain claims were repeatedly rejected by the Patent Office, but Cowles at all times complied with the requirements of Section 4894 R. S. requiring an applicant to reply to the action of the Patent Office within one year, but on seven different occasions he delayed more than eleven months before filing his response to the ruling of the Patent Office.

4. On May 20, 1911, the Patent Office finally rejected the only claim remaining in the application which was directed to the subject matter in issue, holding that it was unpatentable over certain references. On May 17, 1912, Cowles canceled this finally rejected claim from his application, stating his intention to file a divisional application covering the subject matter of this claim. No such divisional application had ever been directed or suggested by the Patent Office. A patent was then (January 21st, 1913) issued without any claim to the subject matter in issue.

5. On August 6, 1912, Cowles filed an application for a patent which he stated was a division of the application filed September 6, 1901, and which disclosed and sought the claims in issue. The patent in suit was issued on this application, on July 14, 1914. During its pendency in the Patent Office, Cowles complied with the requirements of Section 4894 R. S., although on one occasion he delayed over eleven months before responding to the action of the Patent Office.

6. During the period from 1905 to 1912, certain United States and British trade journals published articles disclosing the subject matter in issue, and certain British patents were granted, on subjects relating to such subject matter. Both the publications and patents represented independent work in Great Britain, and as a result thereof, there was actual use of the subject matter in suit abroad during the

pendency of the original and divisional applications above referred to.

7. No product embodying the subject matter of the claims in suit appeared upon the market in the United States prior to the issuance of the patent in suit.

The questions concerning which this Court desires advice are herewith presented.

Question 1. Did the applicant, in canceling the claim which was finally rejected on May 20, 1911, abandon such claim or [fol. 4] estop himself from thereafter seeking it through a new application?

Question 2. In the absence of any other excuse for lapse of time between Patent Office actions and responses thereto, than that the applicant was exercising a statutory right (R. S. Sec. 4894 as amended setting limit of one year for response), may the bill of complaint be dismissed for want of equity because of long pendency in the Patent Office.

The clerk of this Court is directed to transmit a certified copy hereof to the Supreme Court.

Samuel Alschuler, Evan A. Evans, George T. Page, Judges of the United States Circuit Court of Appeals for the Seventh Circuit, Sitting in said Cause.

January 22, 1926.

[fol. 5] Clerk's certificate to foregoing papers omitted in printing.

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BRIEF FOR OVERLAND MOTOR COMPANY.

MELVILLE CHURCH.
CLARENCE B. DES JARDINS.
Counsel for Overland Motor Co.

February 19, 1927.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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BRIEF FOR OVERLAND MOTOR COMPANY.

The certificate of the Court below asks the instruction of this Court as to the proper answer to two questions. The second and more important one will be first considered. It is as follows:

QUESTION NO. 2.

"Question 2. In the absence of any other excuse for lapse of time between Patent Office actions and responses thereto, than that the applicant was exercising a statutory right (R. S. Sec. 4894, as amended, setting the limit of one year for response), may the bill of complaint be dismissed for want of equity because of long pendency in the Patent Office?"

As formulated, the question does not challenge, but rather assumes, the validity of the patent, and assumes, also, literal compliance, on the part of the applicant, with Section 4894, R. S. U. S., requiring action by him each year, during the long period of pendency of his application in the Patent Office, to avoid abandonment.

What the Court below finds itself unable to decide is whether a patentee may, by his course of conduct in the Patent Office, through a long period of time, without other excuse than that afforded by literal compliance with the Statute, disentitle himself to relief in a court of equity.

The question is of transcendent importance, because of the frequency with which inventors, under cover of strict compliance with the Statute, are able to keep their applications pending in the Patent Office for fifteen, twenty and sometimes thirty years, and thus postpone the disclosure of their inventions to the public, as well as the beginning of the running of their patent protection. If such a course of conduct be inequitable, though strictly legal, the Court below is apparently unable to decide, without instruction, whether, sitting as a court of equity, it should grant the patentee equitable relief, or relegate him to his action at law.

Successive Patent Statutes Setting Time Limits for Prosecution of Patent Applications.

An examination of the patent statutes shows an increasing disposition on the part of Congress to prevent abuse of the pendency of an application in the Patent Office.

Section 12 of the Act of 1861 (12 Stat. 246) provided:

> "Section 12. And be it further enacted, That all applications for patent shall be *completed and prepared for examination within two years* after the filing of the *petition*, and in default thereof, they shall be regarded as abandoned by the parties thereto; unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable; * * *." (Italics ours.)

It will be observed that this act contained no provision respecting the *prosecution* of the application after the examination of it. But the Act of 1870 (16 Stat. 198) provided for this by Section 32, as follows:

> "Section 32. And be it further enacted, That all applications for patent shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof, *or upon failure of the applicant to prosecute the same within two years after any action therein*, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable." (Italics ours.)

With slight changes, the provisions of the last named Act were carried forward into Section 4894 of the Revised Statutes, reading as follows:

"Section 4894. All applications for patent shall be completed and prepared for examination within two years after the filing of the *application*, and in default thereof, *or upon failure of the applicant to prosecute the same within two years after any action therein*, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable." (Italics ours.)

In both the Act of 1870 and in the Revised Statutes, therefore, there was the added requirement that the applicant should prosecute his application within two years of any action therein, to prevent abandonment of the same.

Thus stood the Statute until 1897, (29 Stat. L. 693), when Section 4894 R. S. was further amended to reduce the period of prosecution to avoid abandonment, from two years to one year, as follows:

"Section 4894. All applications for patent shall be completed and prepared for examination *within one year* after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same *within one year* after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable." (Italics ours.)

Even with the time limit for action on the part of the applicant thus reduced to one year, it becomes easily possible for an applicant, after an action by the Patent Office upon his application, to delay for the full

period of a year his response to such action, and however promptly the Patent Office may again act, he can delay another full year before replying to it, and thus, by waiting a year after each official action, (1) keep his application pending so as to enable him to withhold, indefinitely, his invention from the public, (2) add claims to his application covering the independent intervening developments of others, and (3) postpone the time when the public may enjoy the free use of the invention—all contrary to sound public policy.

Facts Pertinent to Question No. 2.

From the statement of facts contained in the certificate, it appears that, in the instant case, the patentee, Cowles, filed an application on September 6, 1901, which remained pending until January 21, 1913, when a patent was granted thereon, but without any claim to the subject matter in issue; that certain claims of this application to the subject matter in issue had been repeatedly rejected by the Patent Office, but that the applicant, on seven different occasions, had delayed more than eleven months before filing his response to the ruling of the Patent Office, offering no excuse therefor; that on August 6, 1912, after the only remaining claim in the application of September 6, 1901, directed to the subject matter in issue, had been rejected, the applicant, without any direction or suggestion by the Patent Office to do so, filed another application for patent which he stated to be a division of the application of September 6, 1901, claiming the subject matter in issue; that during the pendency of this application of August 6, 1912, the applicant again complied with the letter of the one year requirement of Section 4894 R. S., although, on one occasion, he delayed over eleven

months before responding to the action of the Patent Office, offering no other excuse for his delay, than literal compliance with said Section 4894; the whole period of pendency of the application of September 6, 1901 and of the so-called divisional application of August 6, 1912, down to the issue of the patent in suit on July 14, 1914, being a little short of thirteen years, during which long period the invention had not been put in use by the applicant, nor disclosed by him to the public as his invention; but that, during the period from 1905 to 1912, other embodiments of the invention, representing the independent work of others, had been publicly disclosed in certain United States and British trade journals and in certain British patents granted to others, and had been put into actual use abroad before the issue of the patent in suit.

Upon such a state of facts, we respectfully submit that the Court below, sitting as a court of equity, is fully justified in refusing to the plaintiffs the equitable relief by injunction and accounting prayed for and in dismissing their bill of complaint for want of equity.

The answer of this Court to Question 2 should, therefore, be "Yes."

Such answer can be made without passing upon the question of the validity of the patent or of the plaintiff's right to litigate it, *in a court of law.*

As we understand the matter, plaintiffs plant themselves four square on the proposition that they are fully protected in their right to equitable relief, without any excuse for their delay, by the terms of section 4894 R. S. U. S., no matter how long by such process of literal compliance the application may have been kept pending. They must take this position, for the findings of the Court below and the language of Ques-

tion 2 make it plain that there was in the case no excuse, such as poverty, sickness, a state of war, or interferences with other applications or patents, or other excuse over which the applicant had no control, which prevented, in any instance, prompt response by the applicant to the official actions. The statement of facts shows that over seven years and fourt months, of the thirteen years of pendency of the Cowles application, were consumed by Cowles in delaying, without excuse, his responses to Patent Office actions. The plaintiffs, therefore, rely upon the letter of the Statute alone and insist that if the applicant responded to the Official action within a year, each time, no matter how long the application was thereby kept pending, that circumstance alone constitutes their all-sufficient excuse.

Courts of Equity Refuse to Enforce Even Statutory Rights, Where Inequitable.

In taking this position, plaintiffs overlook the fact that courts of equity constantly refuse to enforce even statutory rights where, from the course of conduct of the plaintiff, it appears to be inequitable and unconscionable to do so, especially where a remedy at law is available to the plaintiff.

As Mr. Justice Brewer said, in Deweese v. Reinhard, 165 U. S. 386, 390:

> "A court of equity acts only when and as conscience commands, and if the conduct of the plaintiff be offensive to the dictates of natural justice, then, whatever may be the rights he possesses and whatever use he may make of them in a court of law, he will be held remediless in a court of equity."

For instance, it is one of the branches of the jurisdiction of a court of equity to enforce the specific performance of contracts, though, however clear and valid a given contract may appear to be, it will refuse to declare a specific performance of it where to do so would be inequitable; but will relegate the plaintiff to his action at law for damages.

Delay in Asserting or Prosecuting Rights a Ground for Refusal of Equitable Relief.

In Abraham vs. Ordway, 158 U. S. 416, this Court affirmed the dismissal of a bill in equity because of the long-continued delay in asserting the grounds for relief set forth in the bill. The bill seems to have been filed in 1889, and prayed for a decree requiring defendant to convey her title to real estate acquired under a deed of trust executed in 1870, and foreclosed in 1879.

Mr. Justice Harlan, speaking for the Court, said:

> (p. 420) "The relief sought cannot be given consistently with the principles of justice, or without encouraging such delay in the assertion of rights as ought not to be tolerated by courts of equity. Whether equity will interfere in cases of this character must depend upon the special circumstances of each case. Sometimes the courts act in obedience to statutes of limitations; sometimes in analogy to them. But it is now well settled that, independently of any limitation prescribed for the guidance of courts of law, equity may, in the exercise of its own inherent powers, refuse relief where it is sought after undue and unexplained delay, and when injustice would be done, in the particular case, by granting the relief asked. It will, in such cases, decline to extricate the plaintiff from the position in which he has inex-

cusably placed himself, and leave him to such remedies as he may have in a court of law. *Wagner v. Baird,* 7 How. 234, 238; *Harwood v. Railroad Co.,* 17 Wall. 78, 81; *Sullivan v. Portland &c. Railroad,* 94 U. S. 806, 811; *Brown v. County of Buena Vista,* 94 U. S. 157, 159; *Hayward v. National Bank,* 96 U. S. 611, 617; *Lansdale v. Smith,* 106 U. S. 391, 392; *Speidel v. Henrici,* 120 U. S. 377, 387; *Richards v. Mackall,* 124 U. S. 183, 188."

Without pausing to cite further analogies from other branches of the law, it may be truly said that, in the administration of the patent law, the requirement of the prompt assertion and prosecution of the rights of patentees and applicants for patents has become more and more a matter of extreme concern and solicitude on the part of the Courts and anything smacking of inequitable conduct, bearing oppressively upon the public, is being vigorously condemned.

For instance, although a patentee may have a perfectly good patent and a right of action, at law, against an infringer, he cannot, if he long delays in bringing his bill after notice of the infringer's operations, obtain any relief in a court of equity—which abhors a stale claim—but will be relegated to his action at law.

> Lane & Bodley Co. v. Locke, 150 U. S. 193, 200; Walker on Patents, 5th Ed., p. 680, and cases cited.

Equitable Principles Applied in Patent Cases in Absence of Statutory Provisions.

On the other hand, courts of equity sometimes give equitable relief under a statute in cases not specifically provided for by the terms of the statute, where

it is found that general principles of equity demand such action. For instance, the reissue statute (4916 R. S.) provides, in terms, only for the reissue of patents that have claimed too much. But this Court has decided that where the original patent has claimed too little, a broadened reissue may be granted, on principles that would be applied by a court of equity for the correction of a document, such as a contract or a deed, where diligence in the application for relief appears (Topliff v. Topliff, 145 U. S., 156, 170); but it has also held that where there has been a delay of over two years in making the application for reissue, the doctrine of laches will be applied and the reissue be declared invalid.

Miller v. Brass Co., 104 U. S., 350;
Mahn v. Harwood, 112 U. S., 354;
Wollensak v. Reiher, 115 U. S., 96;
Topliff v. Topliff, 145 U. S., 156;
Wollensak v. Sargent, 151 U. S., 221.

It will be observed that, in these reissue cases, time limitations, conformable to general principles applied by courts of equity, are held applicable to a statute which contains, in terms, no time limitations at all.

Again, the only time limitation imposed by statute upon the right of an applicant for patent to amend his application is found in Section 4894 R. S., hereinbefore considered, which gives, as we have seen, the applicant one year after an adverse official action within which to respond thereto. It has, however, been held, by this Court, that, if an applicant delays to insert in his application by amendment a claim that has previously appeared in a patent granted to another more than two years prior to the amendment, such claim will be

barred, upon equitable principles of estoppel and presumed abandonment, in analogy to the two years limitation applied as a bar in reissue cases and to the two years permissible public use allowed patentees before application.

Chapman v. Wintroath, 252 U. S., 126;
Webster Co. v. Splitdorf Co., 264 U. S., 463.

The latest application by this Court of the equitable doctrine of laches as applied to patents is Woodbridge v. The United States, 263 U. S., 50, wherein the practice of voluntarily delaying action in the Patent Office, without excuse, so as to postpone the issue of the patent and, therefore, the time from which the patent begins to run, is most severely criticised, the Court, speaking through Mr. Chief Justice Taft, saying:

(p. 55)

"It was the legislative intention that the term should run from the date of the issue of the patent, and that, at the end of that time, the public might derive from the full specifications required in the application accompanying the patent, knowledge sufficient to enable it freely to make and use the invention. * * * Congress relies for the public benefit to be derived from the invention during the monopoly on the natural motive for gain in the patentee to exploit his invention and to make, use and vend it or its products or to permit others to do so, for profit. The importance in working out the purpose of Congress of keeping the inventor's monopoly within the term for which the patent is granted is thus shown to be capital. *Any practice by the inventor and applicant for a patent through which he deliberately and without excuse postpones beyond the date of the actual invention, the beginning of the term of his monopoly, and thus puts off the free public enjoyment of the useful*

invention, is an evasion of the statute and defeats its benevolent aim."
(Italics ours)

The Bell Telephone Case Not in Point.

The case of U. S. v. American Bell Telephone Co., 167 U. S. 224, will undoubtedly be relied upon by the plaintiffs to justify the delays in the Patent Office of which the defendant complains. That, however, was a proceeding by the Government to cancel a patent absolutely,—to terminate its life. To support the proceeding, it was necessary to show that the patent had been fraudulently secured, and no fraud was found to have been perpetrated. Furthermore, it clearly appears from the opinion that the delay complained of was the fault of the officials of the Patent Office, and that the applicant was in no wise responsible for it.

The Court, speaking through Mr. Justice Brewer, said (p. 262):

> "Our conclusions on this branch of the case are: First, that before the Government is entitled to a decree cancelling a patent for an invention on the ground that it had been fraudulently and wrongfully obtained, it must, as in the case of a like suit to set aside a patent for land, establish the fraud and the wrong by testimony which is clear, convincing and satisfactory. Second, that Congress has established a department with officials selected by the Government, to whom all applications for patents must be made; has prescribed the terms and conditions of such applications, and entrusted the entire management of affairs of the department to those officials; that when an applicant for a patent complies with the terms and conditions prescribed and files his application with the officers of the department he must abide their action, and

cannot be held to suffer or lose rights by reason of any delay on the part of those officials, whether reasonable or unreasonable, unless such delay has been brought about through his corruption of the officials, or through his inducement, or at his instance. Proof that they were in fault, that they acted unwisely, unreasonably and even that they were culpably dilatory, casts no blame on him and abridges none of his rights. Third, the evidence in this case does not in the least degree tend to show any corruption by the applicant of any of the officials of the department, or any undue or improper influence exerted or attempted to be exerted by it upon them, and on the other hand does affirmatively show that it urged promptness on the part of the officials of the department, and that the delay was the result of the action of those officials. And, fourth, if the circumstances do not make it clear that this delay on the part of the officials was wholly justified they do show that it was not wholly unwarranted, and that there were reasons for the action of such officials, which at least deserve consideration and cannot be condemned as trivial."

Here, in the case at bar, the Court is not asked to cancel plaintiff's patent because of the dilatory tactics resorted to in the Patent Office, nor even to declare it unenforceable, at law, as against the defendant, for that reason.

What defendant does ask is the denial to the plaintiff of equitable relief under the patent, and Question 2 is directed to this point, and to this point only.

We, therefore, reiterate that this question should be answered in the affirmative.

QUESTION NO. 1.

The first question is as follows:

> "Question 1. Did the applicant, in cancelling the claim which was finally rejected May 20, 1911, abandon such claim or estop himself from thereafter seeking it through a new application?

Facts Pertinent to Question No. 1.

The facts pertinent to this question as disclosed by the Court's statement of facts are these:

The Cowles application, filed September 6, 1901, contained a claim to the subject-matter in issue, which claim was finally rejected on May 20, 1911, on the ground of its non-patentability in view of certain references.

In response to this rejection, this claim was, on May 17, 1912, canceled, the applicant stating at the time that it was his intention to file a divisional application covering the subject-matter of the claim. No such divisional application had ever been directed or suggested by the Patent Office.

There being, therefore, no requirement nor necessity for a division, what Cowles should have done if he still thought himself entitled to the rejected claim and desired to secure it, was not to cancel it, but to take his appeal from the rejection by the Primary Examiner to the Board of Examiners-in-Chief (Sec. 4909 R. S.) and then, if necessary, to the Commissioner of Patents in person and to the Court of Appeals of the District of Columbia, in turn. But, instead of appealing, he canceled the claim and let his patent issue, without it, on January 21, 1913.

After the claim had been canceled, to wit, on May

7, 1912, as aforesaid, without appeal, Cowles, on August 6, 1912, filed his, so-called, divisional application in which he claimed, again, the subject-matter in issue, which had been canceled after rejection as aforesaid, stating that the new application was filed as a division of the earlier case; this new application, with the renewed claims, went to patent on July 14, 1914, such patent being the patent in suit.

The point upon which the Court below is unable to come to a decision and therefore asks the instruction of this Court for its solution, is as to whether or not Cowles, in canceling, after rejection, the claim from his application of May 20, 1911, without appeal, in law abandoned such claim and estopped himself from thereafter seeking it through a new after-filed application.

Cowles Estopped by Failure to Appeal from Final Rejection.

Defendant's contention is this: The striking out of the claim, after rejection, from the application of September 6, 1901, was a purely voluntary act on Cowles' part. The Patent Office had called for no division and no division was required in the nature of things, because the claim, if allowable at all, was allowable with the other claims in the former application. Cowles was evidently, after more than twelve years of delay, suddenly seized with the notion of speedily getting a patent on the claims that had already been allowed him and of taking the chance of his succeeding in getting the other rejected claim in a subsequently filed application, overlooking the fact that an applicant may not patent his indivisible invention piecemeal by a suc-

cession of patents differing from each only as to claims.

There being in Cowles' case, therefore, no necessity for a division, no requirement for a division, and we may add, no propriety of a division, and the claim in the old application standing rejected, it became the duty of Cowles to promptly appeal and exhaust his remedy by appeal until he got or failed to get the claim.

This, however, he did not do, and not having done it, he could not lawfully, under the ruling decision in Edison's case, 30 App. D. C. 321, further prosecute the claim or the substance of it, in any other application.

Consequently, the filing of the application of April 6, 1912, and the taking of a patent thereon was a vain thing.

The decision of the Court of Appeals of the District of Columbia, *in re* Edison, *supra*, seems to be squarely in point. In that case, Edison had an application pending which had been rejected by the Commissioner of Patents. He had a right of appeal to the Court of Appeals from that rejection, but, instead of exercising that right, he preferred to try and fight out the question of patentability further in a new application. The Court of Appeals held that his failure to take an appeal in the first application rendered the question of patentability *res adjudicata* and estopped him from trying out the same question in the second application.

In the present case, Cowles met with a final rejection from the Examiner on his claim to the subject-matter in issue. He had a right of appeal from that decision but he preferred not to take the appeal and elected to try out the question of the allowability of the claim anew before the Primary Examiner in the second application.

His terming the second application a divisional application was a mere subterfuge, as it had never been called for by the Patent Office and was improper. Cowles did exactly what Edison did, that is, he elected to waive his appeal and to try out the question of patentability once more in a new application.

We submit that the Edison case applies and that plaintiffs are now estopped to assert the validity of the claims granted under the circumstances detailed.

The first question should, therefore, also be answered, "Yes."

Respectfully submitted,

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Counsel for Overland Motor Co.

February 19, 1927.

Supreme Court, U. S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1926.

No. 285.

OVERLAND MOTOR COMPANY

v.

PACKARD MOTOR CAR CO., AND WIRE WHEEL CORPORATION OF AMERICA

On Certificate from the U. S. Circuit Court of Appeals for the Seventh Circuit.

BRIEF FOR PACKARD MOTOR CAR CO. ET AL.

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PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1926.

No. 285.

OVERLAND MOTOR COMPANY

v.

PACKARD MOTOR CAR CO., AND WIRE WHEEL CORPORATION OF AMERICA

On Certificate from the U. S. Circuit Court of Appeals for the Seventh Circuit.

BRIEF FOR PACKARD MOTOR CAR CO. ET AL.

This suit, in which the Packard Motor Car Co., et al., are plaintiffs-appellees, and the Overland Motor Co. is defendant-appellant, is based upon the Cowles patent No. 1,103,567, granted July 14, 1914, the application for which was filed August 6, 1912, as a "division" of an earlier application, filed Sept. 6, 1901 (Statement of Facts, Paragraphs 1 and 4).

The cause having reached the Circuit Court of Appeals on defendant's appeal from the decision of the

District Court—sustaining the patent and finding that defendant had infringed it—the Circuit Court of Appeals has certified to this Court for consideration and advice two "questions of law," together with a statement of the relevant facts out of which those questions have arisen.

Both questions relate to matters of procedure in the prosecution of applications for letters patent before the U. S. Patent Office. The *first* has to do with the established practice of that Office in respect to "divisional" applications, a class of applications which, as repeatedly declared in decisions of this Court, are specially relegated to the discretionary powers of the Commissioner of Patents. The *second* has to do with the prosecution before the Patent Office of Cowles' parent and divisional applications (which eventuated in the patent in suit); and more particularly with the length of time consumed in the prosecution of those applications.

In respect to both questions, it is indisputable upon the facts here certified, that Cowles' applications (original and divisional) were prosecuted at all times and in all respects "strictly as required by the statutes and the rules of the Patent Office" (to adopt the language of this Court in its opinion in a recent case—*Chapman et al. v. Wintroath, infra*).

Such being the undisputed facts of the case, the law as interpreted by the latest decisions of this Court requires that both the certified questions be answered in the negative. For if Cowles' divisional application was made in accordance with the established practice of the Patent Office, and if both applications were "prosecuted strictly as required by the statutes and

the rules of the Patent Office," as appears by the Statement of Facts (Par. 3 and 5), then to answer either question in the affirmative would be to bring about a radical change in the practice of the Patent Office; a change retroactive in its effects, and which would destroy rights that have become vested under the existing statutes and the established practice of that Office.

For the defenses urged in the Court below, and which gave rise to these questions, were such as to demand radically new interpretations of the law, both with respect to divisional applications, and also with respect to the prosecution of ordinary applications. Indeed it is no exaggeration to say that, for the Courts to sustain either of those defenses (or in other words, for this Court to answer either of the certified questions in the affirmative) would be to inaugurate a change of practice so radical as properly to be termed revolutionary; a change, moreover, which would affect the validity of thousands of patents, the applications for which were prosecuted in accordance with the existing and long established rules and practice of the Patent Office.

It is almost superfluous for us to remark that such changes of practice, if made at all, should be effected by Act of Congress, and with all proper regard for the protection of vested rights, unless the existence of some emergency be shown, making it needful for this Court to exercise its extraordinary powers in changing the established practice of an executive Department of the Government. And in this connection it is appropriate to observe that the only *need* for the intervention of this Court in the matters referred to, that has been shown to exist in this case, is the very

pressing need of an adjudged infringer, who is without a defense as the law now stands, and therefore, if not furnished through the efforts and ingenuity of his counsel with a defense new in kind, is in danger of having to bear the consequences of his infringement.

Further we would call attention in these preliminary remarks to the fact that counsel for the defendant-appellant seek to make it appear in their brief in this Court that the subject of *equitable jurisdiction* is involved. For, abandoning their attack upon the validity of the patent in suit, they say in effect (pp. 6, 13) that they are only disputing the right of the patentee to sue for infringement in a Court of Equity. And their reason why this patentee should be deprived of the right to equitable relief is because of the rule that the suitor in a court of equity must come into court with clean hands; and the uncleanness of the complainant's hands in this case consists in the circumstance that its assignor, the patentee Cowles, kept his application pending in the Patent Office longer, in counsel's opinion, than he ought to have done.

The complete answer to this extraordinary proposition is found in the elementary principle of law that the jurisdiction of courts of equity in suits for the infringement of patents arises as an incident to the power of a court of equity to grant relief by way of injunction, it being deemed a matter of high public policy thereby to prevent a multiplicity of suits. The action for infringement is an action *in tort*, and its character is not changed by its being brought on the equity side of the court. "The equity jurisdiction exercised by the courts over patents for inventions is

merely in aid of the common law" (*Root v. Ry. Co.*, 105 U. S. 189, quoting *Sullivan v. Redfield*, 1 Paine 441). There is *no jurisdictional question involved.*

Furthermore, there is obviously no relation whatever between the conduct of Cowles in the prosecution of his patent before the Patent Office, and the right of the assignee of that patent to bring suit thereon in a court of equity.

And finally, when we come to inquire wherein the alleged uncleanness of hands consists, we are pointed to the fact that the applicant Cowles, in a number of instances took *nearly all* (*but never more than*) *the time allowed him by law for making his response to the official actions.* That is the whole brunt of his offending. And whatever may be said of it, most assuredly it does not constitute a case of "unclean hands" in the sense in which that expression is used in connection with the subject of the jurisdiction of courts of equity. Even if there were "undue delay" in the prosecution of Cowles' application (which does not appear by the Statement of Facts, but the contrary), and even if Cowles were wholly or mainly responsible, rather than the Primary Examiner, for the "long pendency" of his application in the Patent Office (which also does not appear by the Statement of Facts), even then we would not have a case of unclean hands, such as would leave the plaintiffs in this case with a valid patent, but bar them from bringing suit thereon in a court of equity. The proposition seems to us to be wholly unprecedented.

We call attention at the outset to a passage from the opinion of this Court in *Chapman et al. v. Wintroath* (252 U. S. 126, 136), because it applies directly to both the certified Questions, and it also bears upon

the novel contention of counsel for the defendant-appellant that plaintiff should be deprived of the right to bring suit upon this Cowles patent in a court of equity because of the applicant's conduct in prosecuting his application before the Patent Office. For this Court has held, in the passage we are about to quote, that when the application for a patent has been prosecuted "strictly as required by the statutes and rules of the Patent Office" the rights of the patentee may not be denied *or diminished,* on the ground that the delay was prejudicial to either public or private interests. This is the passage:

> "There is no suggestion in the record that the original application of the Chapmans was not prosecuted strictly as required by the statutes and the rules of the Patent Office, and therefore it is settled that their rights may not be *denied or diminished* on the ground that such delay may have been prejudicial to either public or private interests" (quoting U. S. v. Am. Bell Tel. Co.). (Ital. ours.)

In the present case it appears by the certified facts that Cowles proceeded "strictly as required by the statutes and the rules of the Patent Office," *both in filing responses seasonably to all official actions, and also in giving notice,* when he withdrew the disputed claim from the parent application, that he did so for the purpose of continuing the prosecution thereof in a divisional application thereafter to be filed.

Therefore, the passage just quoted contains all the law that is needed for the support of a negative answer to both the certified Questions.

We proceed now to the discussion of the two certified questions.

I.

"Question 1. Did the applicant, in cancelling the claim which was finally rejected on May 20, 1911, abandon such claim, or estop himself from thereafter seeking it through a new application?"

It appears by the "Statement of Facts" (Paragraph 4) that the parent application, as it stood after the official action of May 20, 1911, contained certain claims that were allowed (as implied in the last clause of Par. 4), and contained also a claim (addressed to the subject-matter in issue in the present suit) which was "finally rejected;" by which technical expression is meant that said claim had been twice rejected by the Primary Examiner, and was therefore in condition for appeal from his decision to the Board of Examiners-in-Chief.

Further it appears by said Paragraph 4 that, in response to the official action aforesaid, the applicant, on May 17, 1912, "cancelled this finally rejected claim from his application, *stating his intention to file a divisional application covering the subject-matter of this claim;*" (ital. ours) which divisional application was duly filed, August 12, 1912 (Par. 5). That was *before the issuance of the patent on the parent application*, which patent issued January 21, 1913 (Par. 3).

It thus appears that the cancelling of the claim in question, so far from evincing "an intention to give up effort to secure a patent" (*Woodbridge et al., v. The United States, infra*) was done with the intention on the part of the applicant, expressly declared by him at the time, and for the very purpose, of continuing his efforts to secure a patent for the subject-matter of that claim by the filing of a "divisional applica-

tion" therefor. The withdrawal of the claim from the parent application was a necessary step in the regular procedure, prescribed by the Rules of Practice of the Patent Office, for the dividing of an application. Therefore, the action *per se* did not affect in any way whatever the status of the claim, or the applicant's right to continue his efforts to secure a patent for the subject matter thereof.

It can hardly be supposed that the Court below was "in doubt" as to whether an applicant, by withdrawing a claim from a pending application with the declared purpose of filing "a divisional application covering the subject-matter thereof," did thereby "abandon such claim or estop himself from thereafter seeking it through a new application." For there can be no possible *doubt* as to that.

Evidently, therefore, the reason why the Court below was "in doubt" touching this matter is that the claim, which the applicant Cowles removed from his application for the purpose of incorporating it in a divisional application, had been "finally rejected;" that is—according to the signification of that technical phrase—it had been twice refused by the Primary Examiner. Hence the Court below in effect asks: Does the fact that the claim had reached the "final rejection" stage of its prosecution, when withdrawn for incorporation in a divisional application, give to that withdrawal a legal effect it would not have had at an earlier stage of the proceedings, and entail consequences of a fatal character which otherwise would not have ensued?

Counsel for defendant-appellant likewise understand the question in this sense. For in their brief in this Court, after declaring that Cowles, "if he still

thought himself entitled to the rejected claim" should have prosecuted an "appeal from the rejection by the Primary Examiner to the Board of Examiners-in-Chief" (p. 14) go on to say:

> "The point upon which the Court below is unable to come to a decision, and therefore asks the instruction of this Court for its solution, is as to whether or not Cowles, in cancelling *after rejection*, the claim from his application of May 20, 1911*, without appeal, in law abandoned such claim and estopped himself from thereafter seeking it through a new after-filed application." (P. 15, italics ours.)

And again:

> "Defendant's contention is this: The striking out of the claim, *after rejection*, from the application of September 6, 1901, was a purely voluntary act on Cowles' part" (*id.* ital. ours).

Counsel on both sides are thus in agreement as to the purport of question 1. All are agreed that the significance of the question is found in the words "finally rejected." What therefore is to be determined is, whether or not the dividing of a patent application *at that particular stage of the proceedings*, works—*ipso facto* and regardless of applicant's expressed *intention* to the contrary, the abandonment of the claim which he thus essayed to transfer to a divisional application.

Or the question may be paraphrased thus: Does the well established right of an applicant to divide his

*Counsel have made a slip here in regard to the date. For *May 20, 1911*, is not the date of the application, but of the Examiner's action rejecting the claim in question.

application (the Patent Office acquiescing) cease in respect to a claim which the Primary Examiner has "finally rejected"? And if so, is it the doctrine of this Court that the subject matter of a "finally rejected" claim which has been transferred to another application, the Patent Office acquiescing, is to be adjudged abandoned?

In this connection, however, attention must be given to another fact, namely that "no such divisional application had ever been directed or suggested by the Patent Office" (Statement, Par. 4). In other words, the divisional application in this case was not required or suggested by the Patent Office, but was the applicant's voluntary act, in which, however, the Patent Office acquiesced.

Counsel for defendant-appellant lay considerable stress, in their brief in this Court, upon the fact just noted. And inasmuch as the fact is included in the "Statement" certified by the Court below, though not included in the "Question," it is properly to be considered in the discussion of that Question.

As regards *Question 1* therefore, we have to consider—

First, the general subject of *abandonment of an invention by the conduct of the inventor in the course of the prosecution of his application for patent in the Patent Office.*

Second, whether the withdrawal of a claim from a pending application, with the declared intention of incorporating the subject-matter thereof in a divisional application, is to be adjudged an abandonment of that

subject-matter *in the special case of a claim which had been twice rejected by the Primary Examiner.*

Third, whether a divisional application made upon the *applicant's own motion,* with the acquiescence of the Patent Office, stands on a different footing with respect to the matter of law inquired of in Question 1, from a divisional application made in compliance with a requirement of the Patent Office.

1. Does the Conduct of This Inventor Amount to Abandonment?

It is the long and well settled doctrine of the Federal Courts that abandonment is a question *of fact;* that it is not to be presumed, but must be established by clear proof; and that if the proof adduced in support of the defense of abandonment be *the conduct of the inventor,* then the evidence must establish that his conduct was such as clearly to evince "*an intention to give up effort to secure a patent.*"*

In *Kendall v. Winsor* (62 U. S. 322) it was decided (and so the Courts have consistently held from that time to the present), that "The real *intention* of an inventor with respect to an assertion or surrender of his rights * * * is an inquiry or conclusion of *fact*" (ital. ours).

In *Mast v. Dempster* (82 Fed. 327, C. C. A. Eighth Cir.), the Court held that while—

> "an abandonment may undoubtedly be proved within two years prior to the filing of the application," yet "it ought not to be presumed, and it should be established by convincing evidence

*The quoted words are from the decision of this Court in *Woodbridge et al.* v. *The United States, infra.*

> of *the intention* of the owner of the invention to dedicate it to the public. An abandonment is a dedication, and like any other dedication it should be clearly proved. It rests upon *the intention* of the inventor."

And in *Ide v. Trorlicht* (115 Fed. 137) the same Court said:

> "Clear evidence of *an intention* to dedicate an improvement to the public is indispensable to establish abandonment."
>
> (See also the decision of this Court in *Godfrey v. Eames*, quoted below.)

Therefore, under the settled law, as stated in the foregoing decisions, the controlling factor on the issue of abandonment or estoppel by conduct is the *intention* of the inventor. The burden of proof lies upon the defendant; and to establish the defense of abandonment it must be clearly proved that the inventor "*intended* to give up and relinquish his right to take letters-patent" (*Kendall v. Winsor, supra*). Hence the question we are considering is effectually disposed of by what appears in the "Statement of Facts" formulated by the Court below; namely, that "On May 17, 1912, Cowles cancelled this finally rejected claim from his application, stating *his intention to file a divisional application covering the subject matter of this claim*" (Par. 4; ital. ours).

Here, then, we have the clearest possible proof as to *the intention of the inventor*, which is the determinative factor in the question of abandonment. And that proof is fortified by the further fact that the applicant carried out his declared intention, by filing forthwith a divisional application for the subject

matter of said claim, and by prosecuting that divisional application to a successful issue.

2. Does the Fact that the Claim had been "Finally Rejected" Make the Withdrawal thereof an Abandonment?

We submit that the settled doctrine touching abandonment by conduct, as set forth above, disposes completely of this phase of the question also. For whether it be at one stage or another of the prosecution of an application in the Patent Office, the significance and legal effect of the erasure of a claim depend upon *the intention of the inventor,* upon *what his purpose was* in directing the erasure thereof. And manifestly, if the erasure of a claim, *for the declared purpose of continuing the prosecution thereof in a divisional application, evinces,* if done at one stage of the proceedings, the applicant's intention to continue his effort to secure a patent therefor, it cannot be that the very same action, taken at another stage of the proceedings, is a manifestation of just the opposite intention on his part.

It is conceivable that the Court below attributed to the technical phrase, "finally rejected," a meaning it does not in fact have; for the expression is calculated to give to persons not acquainted with the technical usage thereof, the idea that the proceedings in the Patent Office had reached a finality. But it is not disputed here—indeed it appears affirmatively in the brief for defendant-appellant (pp. 14, 15)—that, when the claim was withdrawn for the purpose of a division the proceedings were at the stage where the applicant might have taken "his appeal from the rejection *by*

the Primary Examiner to the Board of Examiners-in-Chief;" and that he withdrew said claim "*without appeal.*" (ital. ours).

Such being the case, the withdrawal of the claim for the purpose of continuing the prosecution thereof in a divisional application has precisely the same significance at the stage of final action by the Primary Examiner that it has at every other stage. In that special case and situation, as in every other, *the status of a claim, withdrawn for incorporation in another application, is not in anywise changed thereby.* The applicant neither gains nor loses any rights whatever by the transfer of a claim from one application to another. For the original and divisional applications are regarded, for all the purposes of the Statute, as parts of one and the same proceeding (*Godfrey v. Eames,* 68 U. S. 317, quoted below). In the case of a claim which the Primary Examiner has twice rejected, the applicant does not, by transferring it to a divisional application, gain the right to demand further consideration thereof *by the Primary Examiner;* for the latter may simply reject the claim *pro forma,* leaving the applicant to proceed by way of appeal to the Examiners-in-Chief.

Of course, it is always *permissible* for an Examiner, in his discretion, to give renewed consideration to a claim, even after he has "finally rejected" it. But he is no more *obligated* to give further consideration to such a claim when presented in a divisional application, than when left in the original application.

Now as regards the particular stage of the proceedings in the Patent Office at which the division in this case was made, we ask the Court to observe that the situation of the parent application, as it stood after

the official action of May 20, 1911, was such as to make the division thereof a particularly appropriate procedure. For, by dividing the application at that precise juncture of affairs, the applicant separated the contested part of the subject-matter from the allowed part thereof, thus facilitating the further prosecution of the case. Furthermore, he thereby made possible *the immediate issuance of a patent covering all the claims which had been adjudged patentable;* whereas otherwise *all* the claims would have been tied up to await the final outcome of the further prosecution of the rejected claim.

This is a very pertinent matter, for the reason that the wrongdoing charged against the applicant in the Court below was that he had resorted to the expedient of dividing his application for the reprehensible purpose of prolonging the period of the prosecution thereof, and delaying the issuance of the patent. Whereas, on the contrary, the manifest purpose and result were to *expedite* the grant of the patent for all the claims that had been adjudged patentable up to that time.

We submit, therefore, that, the subject-matter of the Cowles application being properly divisible (a matter which lies in the discretion of the Commissioner, as shown by the authorities cited below) the applicant had *precisely the same right* to transfer the claim in controversy to a divisional application at the "final rejection" stage of the proceedings as at any other. And particularly we contend, the division having been permitted by the Patent Office, and rights having become vested by the grant of a patent on the divisional application, that the action of the Patent Office in that regard should not be reviewed and reversed, and a novel doctrine of abandonment promulgated at the

instance, and for the benefit, of an infringer of the patent.

3. Does a Divisional Application Made Upon the Applicant's Own Motion Stand Upon a Different Footing from One Made at the Instance of the Patent Office?

According to the long established practice of the Patent Office an application for a patent may be divided, either upon the initiative of the applicant himself, or at the instance of the Patent Office. It makes not the slightest difference—as regards any question arising in this case—with whom the proposal for the dividing of the application may have originated. It is immaterial whether the Patent Office required it and the applicant complied, or the applicant proposed it, and the Patent Office consented. Either way, the procedure was lawful, regular, and not—except for some extraordinary reason—subject to review by the Courts (See authorities cited below).

For either way, the Patent Office is the judge both of the divisability of the subject-matter, and also of the propriety of the division; it having been recognized and declared by this Court that the whole subject is one concerning which "*discretion must be left to the Patent Office*" (*Webster Co. v. Splitdorf Co.*, 264 U. S. 463).

Authorities in Support of the Foregoing Propositions.

The pertinent authorities fully, and so far as we can find *unanimously*, sustain the foregoing propositions.

Thus, in *Kinnear Mfg. Co. v. Wilson* (142 Fed. 970),

the Court of Appeals of the second circuit affirmed a decree upholding a patent which had been granted upon a new application of Kinnear's, the claim in suit being substantially the same as a claim that had been *finally rejected* in a prior application and cancelled. The court said:

> "We quite fail to appreciate the argument for the appellant to the effect that in some way the proceedings in the Patent Office amounted to an estoppel or an abandonment precluding the patentee from asserting the validity of the third claim. It is quite unimportant that various claims in both applications were rejected, and the rejection acquiesced in by Kinnear, so long as the Office finally granted the claim which is now in controversy. Nor does it matter that a claim substantially like the one now in controversy was twice rejected by the Office. If the identical claim had been thus rejected, it was nevertheless competent for the Office to reconsider its action."

The present case stands on a much better footing than the above, in that the second Cowles application was filed *as a division* of the first, and for the expressly declared purpose of continuing the prosecution of the "rejected" claim. For, as this Court has remarked in a recent decision (*Chapman et al., v. Wintroath, infra*) divisional applications "have not been dealt with by the Courts in a hostile spirit," but rather have been "favored."

THE DISCRETION OF THE COMMISSIONER OF PATENTS.

And furthermore, applications of that sort are deemed by the Courts to be, as Mr. Justice Nelson expressed it, "very much left, and reasonably so, to the

good sense and discretion of the Commissioner" (*Goodyear v. Wait, infra*).

Nothing more than the recognition of the discretionary powers of the Commissioner with respect to divisional applications is required for the determination of the answer to Question 1. For surely it may with all propriety be left to his "good sense and discretion" to say whether or not the divisional application was made at a suitable stage of the proceedings in the Patent Office.

The following passage from *Chapman et al., v. Wintroath* (252 U. S. 126, 137), declares the general attitude of the Courts towards divisional applications:

> "To this we must add that not only have later or divisional applications not been dealt with in a hostile spirit by the courts, but, on the contrary, designed as they are to secure the patent to the first discoverer, they have been favored to the extent that where an invention clearly disclosed in an application, as in this case, is not claimed therein, but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice, and the later one will be given the filing date of the earlier, with all its priority of right."

We note in passing that in the case of *Chapman, et al., v. Wintroath,* the applicants had filed their divisional application some twenty months after adverse interests had accrued through the issuance of a patent to Wintroath; and this Court held that they were within their legal rights in so doing. In the present case, *per contra,* no adverse interests accrued prior to the filing of the divisional application of Cowles, or even prior to the issuance of the patent thereon (Statement of

Facts, Par. 7). For obviously no adverse interests accrued by reason of the facts recited in Paragraph 6 of the Statement; namely that the subject-matter in issue was published in certain U. S. and British trade journals and in certain British patents, and that there was use *abroad* "during the pendency of the original and divisional applications above referred to"—there being nothing of the sort *before* the filing of the original application.

Further touching the discretionary powers of the Commissioner in regard to the whole subject of *divisional applications*, we direct attention to the decision of this Court in *Steinmetz v. Allen* (192 U. S. 543) from which we quote as follows:

> "In *Bennet v. Fowler* (8 Wal. 845) a discretion in the Patent Office was recognized."

And quoting from the opinion in the cited case, the Court goes on to say:

> "It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question."

And with reference to an arbitrary rule of the Patent Office in force at that time this Court said:

> "Without that rule, the action of the Patent Office can be accommodated to the character of invention, and discretion can be exercised, and when exercised, we may say in passing, except in cases of clear abuse, the court will not review it."

Mr. Justice Nelson, sitting at Circuit in the Southern District of New York, had spoken to the same effect in *Goodyear v. Wait* (3 Fisher, 242) as follows:

> "As to separate patents, we agree that both claims might properly have been embraced in one; but this question is one that is very much left, and reasonably so, to the good sense and discretion of the Commissioner."

Our contention in regard to the discretion committed to the Patent Office in the matter now under discussion is fully supported by the decision of this Court in *United States ex rel. Steinmetz v. Allen,* 192 U. S. 543, which contains this pertinent passage:

> "The action of the Patent Office can be accommodated to the character of inventions, and discretion can be exercised; and where exercised, we may say in passing, *except in case of clear abuse, the courts will not review it.*"

There is nothing in this case to indicate that the Patent Office abused its discretionary powers in permitting Cowles, of his own motion, to file a divisional application embracing the matter disallowed in his original application.

And there is nothing whatever to militate against Cowles in the circumstance noted in the Statement of facts as to the absence of direction or suggestion by the Patent Office that the division should be made. Voluntary or optional divisions have always been recognized. For example, the Court of Appeals for the Second Circuit in *Thomson-Houston Electric Co. v. Elmira and Horsehead Railway Co.* (71 Fed. 396) said:

> "While two or more inventions residing in the same combination or structure may be covered by a corresponding number of claims in a single patent, the law does not require them all to be claimed in the same patent, and the invention may, *at the option of the patentee*, be secured by different patents." (Italics ours.)

Similarly, the Court of Appeals for the Eighth Circuit in *Century Electric Co. v. Westinghouse Electric and Manufacturing Co.* (191 Fed. 350) said:

> "But one who makes several patentable inventions that result in a new and useful machine or process, or both, may have as many separate Letters Patents as he makes patentable inventions. *His is the option* to secure all these inventions by a single patent, or by many patents; and the fact that he describes all of them in his application or specification for an earlier patent to secure one or more of them, does not invalidate a subsequent patent to him for those inventions thus described but not claimed." (Italics ours.)

The following passage from the decision of this Court in *Godfrey v. Eames* (68 U. S. 317) declares the close relationship between two applications, where the second was filed *with the intent* that it should be a continuation of the first; though the decision would not be in all respects applicable today, because of changes in the law and practice pertaining to divisional applications:

> "In our judgment, if a party choose to withdraw his application for a patent and pay the forfeit, *intending at the time of such withdrawal to file a new petition, and he accordingly does so*, the

> two petitions are to be regarded as *parts of the same transaction*, and both as *constituting one continuous application within the meaning of the law*" (Italics ours).

Such is the law touching divisional applications to the present hour, assuming the subject-matter to be properly divisable and all the rules pertaining to divisions to have been complied with; as to all of which the action of the Patent Office is not reviewable by the Courts, except in the case of a clear abuse of discretion.

If, therefore, there could arise, upon the facts stated in the Certificate of the Court below, any question of irregularity or impropriety as to the division of the Cowles application,—either in respect to the stage of the proceedings at which it was made, or in any other respect whatsoever—that question would be disposed of completely by *the action taken by the Patent Office upon the divisional application.*

Contentions of Defendant-Appellant as to Question 1.

Counsel for defendant-appellant state (but without saying why) that, of the two certified Questions, the second is "the more important one," and they accordingly take the liberty of inverting, in their brief, the order in which those Questions are presented to this Court by the Court below. And indeed, from their manner of treating Question 1, we should infer that it was not to their liking at all.

For to begin with, "Defendant's Contention" with respect to Question 1, as stated by themselves (p. 15), presents not even the semblance of a showing of illegal, inequitable, or unconscionable action, or any improper

motive, on the part of Mr. Cowles, in dividing his application. And even in this singularly unimpressive statement of the grounds of their grievance, counsel have found it necessary to resort to highly strained rhetoric, and to go far afield from the certified facts, in order to formulate the basis of a defense. This is how they put it:

> "Cowles was evidently, after more than twelve years of delay, suddenly seized with the notion of speedily getting a patent on the claims that had already been allowed him and of taking the chance of his succeeding in getting the other rejected claim in a subsequently filed application, overlooking the fact that an applicant may not patent his indivisible invention piecemeal by a succession of patents differing only as to claims."

It is clear that the proposition here submitted to the Court rests wholly upon the assumption that Cowles' parent application was "indivisible," the only charge here brought against him being that he overlooked that "fact." What this means is simply that counsel for defendant-appellant have no basis for argument in the facts certified to this Court in the Statement of the Court below, which, so far from averring that the subject-matter of Cowles' application was "indivisible," sets forth that Cowles, having declared "his intention to file a divisional application for the subject-matter of this claim" (Par. 4), subsequently "filed an application which he stated was a division of the application filed September 6, 1901, and which disclosed and sought the claims in issue" (Par. 5). And further it appears that the Patent Office entertained that application as a proper division, for the Statement goes

on to declare that, "The patent in suit was issued on this application, on July 14, 1914" (Par. 5).*

It is plain, therefore, that "defendant's contention" has no basis in fact.

But counsel did not stop at the above noticed attempt to supply a basis for argument by means of an assumption directly contrary to the certified facts of the case. They follow it with this paragraph (p. 16):

> "There being in Cowles' case, therefore, no necessity for a division, no requirement for a division, *and we may add, no propriety of a division,* and the claim in the old application standing rejected, it became the duty of Cowles to promptly appeal and exhaust his remedy by appeal" etc. (italics ours);

Counsel here assume again, without the slightest warrant in the certified Statement of facts, but directly contrary to the import thereof—that there was "no propriety of division;" though they preface that assertion with the words, "And we may add," showing that their own word is the only foundation for it. On that basis they argue that it became Cowles "duty" to appeal to the Examiners-in-Chief from the adverse action of the Primary Examiner. But the argument falls to the ground for lack of support in the Statement of Facts.

Whatever might have been Cowles "duty" upon the state of facts which counsel have here been pleased to assume, it is clear that, upon the *real* state of facts, as

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*An official copy of this patent in suit will be found at the end of this brief. We call attention to the words at top of specification: "*Original application filed September 6, 1901. Serial No. 74,497.* **Divided and this application filed August 6, 1912. Serial No. 713,650.**"

certified to this Court, there was *a choice of procedures* open to Cowles, under the rules of the Patent Office and the decisions of the Courts (*Duryea and White v. Rice*, 28 App. D. C., quoted below). For he might continue his efforts to secure a patent for the rejected claim, either (1) by prosecuting an appeal in the then pending application, or (2) by transferring the subject of said rejected claim to a separate application, by filing a new petition and paying a new fee (*Godfrey v. Ames*, 68 U. S. 317, *supra*). Whatever he could do in the one application he could do in the other, neither more nor less. And Cowles chose the alternative of filing a new application.

The opinion of the Court of Appeals of the District of Columbia in *Duryea and White v. Rice*, contains the following pertinent passage:

> "When the claims therefor were rejected, for the reasons given, *he had his election to insist thereon and appeal from a second rejection, or to accept the action of the Patent Office, take his patent for the igniter, and then file another application for a patent for the invention of the engine.* * * * Until all the objections to the final application had been met and overcome, and the same had been finally allowed for patent, Rice was not put finally upon his election to accept the action necessitating the division of his application. When the time arrived for him to take final action, he filed the divisional application with the required diligence, and thereby preserved the continuity of the first for his protection as the inventor of the engine of the issue." (italics ours.)

Cowles had a similar election; and he chose the second alternative described in the opinion of the Court.

Touching the Doctrine of Res Judicata.

At this point in their brief Counsel for the defendant cite the decision of the Court of Appeals of the District of Columbia *in re Edison* (30 App. D. C. 321) as authority for the proposition that Cowles could not lawfully "prosecute the claim, or the substance of it, in any other application." But the decision in the *Edison Case* lends no support whatever to that proposition; rather, so far as it is at all pertinent, its bearing is the other way. For in the *Edison Case* there had been *a final adjudication of the claim in question by the Commissioner in person on appeal,* who affirmed the concurrent decisions of the two lower tribunals rejecting the claim. ~~Thereupon the applicant cancelled the rejected claim, and accepted a patent for the allowed claims, without either filing a divisional application for the subject-matter of said claim, or giving notice of an intention so to do.~~ Therefore, when Edison later on filed a new and original application for the subject matter of that claim, the doctrine of *res judicata* was applied; and the applicability of that doctrine was affirmed by the Court of Appeals of the District of Columbia, ~~their decision being based upon the action of the applicant in cancelling the claim after a final adverse judgment of all three tribunals of the Patent Office, and without any reservation of right to file another application therefor.~~

What that Court holds as the law in a case such as the present, is apparent from their decision in the earlier *Barratt* case, cited in their decision *in re Edison.* Quoting from the *Barratt* case (14 App. D. C. 255) we call attention to a significant qualification by the Court of the affirmance of the Commissioner of Patents' re-

jection of Barratt's second application on the ground of *res judicata*:

> "In what we have said we do not desire it to be understood that the Patent Office may not, if it thinks proper so to do, entertain and adjudicate a second application for a patent after the first application has been rejected. What we decide is that it is not incumbent upon the Office as a duty to entertain such applications and that if it refuses to entertain it has a perfect legal right so to do. An applicant is not legally aggrieved by such refusal."

This qualification, moreover, was reiterated and confirmed by the same court in *Gold v. Gold* (34 Appeals D. C. 229, 150 O. G. 570, decided several years after *in re Edison*). We quote from *Gold v. Gold* as follows:

> "It is also settled that where an application has been finally rejected by the Commissioner in an *ex parte* proceeding, that adjudication may be relied on by him as conclusive on a second application for the same invention. (In re Barratt's Appeal, D. C 1899, 320; 87 O. G., 1075; 14 Appeals D. C. 255; in re Fay C. D. 1900 232; 90 O. G. 757; 15 Appeals D. C. 515; in re Edison C. D. 1908, 327; 133 O. G. 1190; 30 Appeals D. C. 321). A qualification of this doctrine was indicated by the following language in the opinion by Justice Morris in Barratt's case:
>
> 'In what we have said we do not desire it to be understood that the Patent Office may not, if it thinks proper so to do, entertain and adjudicate a second application for a patent after the first application has been rejected. What we decide is that it is not incumbent upon the Office as a duty to entertain such applications, and that if

it refuses to entertain, it has a perfect legal right so to do. An applicant is not legally aggrieved by such refusal.'

Therefore, in so far as the public interest, of which the Commissioner is the representative, was concerned, it seems that he had the power to permit this reconsideration and allowance."

In conclusion as regards Question 1, it is appropriate to observe that the doctrine of *res judicata* applies only in cases where these three conditions are present: (1) a prior adjudication; (2) a subsequent and distinct proceeding—*e. g.* a *new*, not a *divisional*, application; (3) an identical issue. Those conditions were all found by the Court in the Edison case. *Not one of them appears in this* case.

II.

"Question 2. In the absence of any other excuse for lapse of time between Patent Office actions and responses thereto, than that the applicant was exercising a statutory right (R. S. Sec. 4894, as amended, setting limit of one year for response) may the bill of complaint be dismissed for want of equity, because of long pendency in the Patent Office?"

We deem this question to be answered squarely and completely by the decisions of this Court in *United States v. American Bell Telephone Co.* (167 U. S. 224); and *Chapman v. Wintroath* (252 U. S. 126). This will sufficiently appear from the passages we are about to quote from those decisions.

In the Telephone case, the Court, after remarking

that it was not the *fact* of the delay in the Patent Office, but the *excessiveness* thereof, that gave rise to the complaint, said:

> "The mere *fact* of delay does not, therefore, operate to deprive the inventor of his legal rights. Before he can be punished, it must be shown that he has been guilty of a wrong—that *he caused the delay.* It matters not whether the delay be reasonable or unreasonable, for a brief time or for many years, *if the applicant is not responsible for it.*" (ital. ours).

This indisputably sound principle is of the utmost importance in the present case. For, as we ask the Court particularly to observe, it does not appear by the Statement of facts that Cowles "caused the delay," or that he was in anywise legally "responsible for it." Counsel for defendant apparently indulge the hope that the Court will take Cowles' responsibility for the delay for granted. But what does the Statement of facts show? We quote:

> "*Certain claims were repeatedly rejected by the Patent Office, but Cowles at all times complied with the requirements of Section 4894 R. S. requiring an applicant to reply to the action of the Patent Office within one year; but on seven different occasions he delayed more than eleven months before filing his response to the ruling of the Patent Office*" (Par. 3).

And again, speaking now of the divisional application:

> "*During its pendency in the Patent Office Cowles complied with the requirements of Section 4894*

R. S., although on one occasion he delayed over eleven months before responding to the action of the Patent Office." (Par. 5).

Our position of course is, and the decisions of this Court amply sustain us, that Cowles is liable to *no* penalty, and to no curtailment of his rights, because he, on seven or eight occasions, took *nearly all the time allowed him by the statute for responding to its official actions;* for he was legally entitled to every hour of it. To that proposition we are coming presently.

But our contention at this point is that, even in respect to the *perfectly legal delay,* which constitutes the sole ground of defendant's complaint, it does not appear that the responsibility rests with the applicant Cowles. For at no time was he holding back (as in the Woodbridge Case for example) the issuance of a patent which the Patent Office was willing to grant. On the contrary, he was at all times, and with commendable persistence and unremitting effort, seeking to procure the issuance of a patent for claims which the Examiner (wrongfully, as may be inferred from the sequel) "repeatedly rejected."

It is now established, not alone by the decision of the Patent Office, but by the judgment of the District Court as well, that *the subject-matter in issue was patentably novel with Cowles.* Whose fault then was it, if any fault there be, that the patent to Cowles was not issued sooner and that the claims were "repeatedly rejected" before the patent was at last allowed? Certainly not the fault of the applicant; for he was ever pressing for the allowance of claims to the disputed subject-matter until at last they were granted. Now we do not for a moment suggest that any blame whatever attaches to the Examiner for the

delay; for there is no reason to doubt that he was at all times acting conscientiously in the discharge of his official duties. Yet it is clear as regards the responsibility for the "long pendency" of Cowles' application, that the certified facts point rather to the Patent Office than to the applicant.

The certified facts, moreover, refute completely any suggestion of bad faith on the part of the applicant Cowles in the prosecution of his application. No obligation lay upon him (or upon his assignee) to explain why, on a number of occasions, he delayed nearly a year the filing of responses to the Examiner's rejections. Nor is there anything in the Statement of Facts to warrant the inference that there were not the best of reasons for the delays.

We maintain therefore that, upon the facts as stated, no responsibility whatever attaches to the applicant for even such delays as did occur.

Now as to the legal effect of the "long pendency" of the Cowles application in the Patent Office, even if it were shown that Cowles were wholly responsible for it, the following from the decision of this Court in the *Telephone Case*, would effectually dispose of the matter:

> "Neither can a party pursuing a strictly legal remedy be adjudged in the wrong, if he acts within the time allowed, and pursues the method prescribed by the statute."

Cowles admittedly did both.

We call attention specially to a passage in *Chapman v. Wintroath* (252 U. S. 126) in which this Court quotes from its opinion in the *Telephone Case*, and applies the

doctrine there laid down to a situation similar to that presented in the case at bar:

> "There is no suggestion in the record that the original application of the Chapmans was not prosecuted strictly as required by the statutes and the rules of the Patent Office *and therefore, it is settled, their rights may not be denied or diminished on the ground that such delay may have been prejudicial to either public or private interests.* 'A party seeking a right under the patent statute may avail himself of all their provisions, and the court may not deny him the benefit of a single one. These are questions not of natural but of purely statutory rights. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public.' *United States v. American Bell Telephone Co.*, 167 U. S. 224, 247." (ital. ours).

All that counsel for the defendant-appellant have to oppose to these pertinent decisions is their bald assertion that the *Telephone Case* is "not in point," because the issue in that case was not the infringement of a patent, but—fraud in procuring it (brief, p. 12). And as regards the pertinence of the decision in *Chapman v. Wintroath* to the matter now under discussion they have not one word to say, though they cite that decision for another purpose (p. 11).

As to the ground on which our opponents seek to avoid the effect of the *Telephone Case*, we say that, notwithstanding the issue there was fraud and here it is infringement, the doctrine and principles of law declared in that decision apply directly to the present case, and

effectually dispose of Question 2. This is obvious from the language of the decision itself; but if other, and more conclusive proof thereof be desired, it is to be found in the fact that *this Court has cited and applied its decision in the Telephone Case to the case of Chapman v. Wintroath* (see passage last quoted above). For in the latter case there was no issue of fraud or anything akin to it; but, as here, the sole question before the Court was whether the rights of an applicant for patent were lost or impaired by mere postponement of action, where the delay did not exceed the statutory limit.

We ask attention also to the decision of the Circuit Court of Appeals (Fourth Circ.) in *Crown Cork and Seal Co. v. Aluminum Stopper Co.* (108 Fed. 845) where, in dealing with the matter of the delays of an inventor (Painter) in prosecuting his application, the Court said:

> "The inventor does not determine the measure of his rights or of his obligations. The law determines that for him, and, *if the government thinks that more speed is desirable in the interest of the public, it should change the law; the courts cannot do so.*"

We refer also to the decision of the Circuit Court of Appeals (Second Circ.) in *Columbia Motor Car Co. v. C. A. Duerr & Co. et al.* (184 Fed. 893) wherein, with regard to long delays in the prosecution of the application for the patent in suit, the Court said:

> "If the statutes and rules permit unnecessary delays, they should be changed; but we reject the view that this court owes any duty to relieve against their operation."

The further observations we feel called upon to make as to Question 2 can best be presented in the form of running comments on the brief of counsel for the defendant-appellant.

1. Counsel for defendant-appellant give, on Page 2 of their brief, their version of Question 2, saying that—

> "What the Court below finds itself unable to decide is whether a patentee may, by his course of conduct in the Patent Office, through a long period of time, without other excuse than that afforded by literal compliance with the Statute, disentitle himself to relief in a Court of Equity."

And counsel proceed to say that: "*The question is of transcendent importance.*"

Whether this question as formulated by defendant's counsel be of transcendent importance or not, we do not stop to inquire, for certainly it is not the question certified to this Court for determination. And if it were, this Court would not consider it, for what we have quoted above from defendant's brief is purely a moot question (*Mills v. Green*, 159 U. S. 651; *Heitmuller v. Stopes*, 256 U. S. 359).

The inquiry here is—not whether a patentee "*may*, by his course of conduct in the Patent Office, * * * disentitle himself to relief in a court of equity," but—whether *upon the facts as stated by the Court below*, the bill of complaint *in this case* should be dismissed for want of equity, because of long pendency in the Patent Office. We have nothing to do with counsel's hypothetical cases. For there is no need that either the Court or counsel should give themselves any concern as to the possibility of "applications pending in the Patent Office fifteen, twenty and sometimes thirty years."

Manifestly, such cases, should they ever arise, will be judged each by its own facts. But what the Court has now before it is a case in which there is nothing whatever to indicate that the applicant had not, in each instance, a valid reason, perfectly compatible with equity and good conscience, for taking all the time he did take for making his response to the action of the Patent Office. *Per contra,* it definitely appears that he was persistent and unremitting in his efforts to secure the allowance of claims for the disputed subject matter; that on the other hand the Examiner refused such claims again and again, though in the end he acknowledged the applicant's right to them; that the latter continued his efforts against great discouragements, and obviously under the burden of heavy expense; and that finally he triumphed over all obstacles and secured the issuance of a patent for the long disputed subject matter *before the invention had come into use in this country.*

2. The argument on pages 3-5 of our opponents' brief might conceivably have some relevancy if this were a proceeding before the Congress of the United States in respect to a proposed amendment to the Statute, proposing still further to curtail the time limit for making responses to Patent Office actions. But we fail to perceive that it has any relevancy whatever to the Questions c[illegible]fied to this Court.

3. It is stated (p. 5 of brief for defendant) that "the applicant, on seven different occasions, had delayed more than eleven months before filing his response to the ruling of the Patent Office, *offering no excuse therefor.*" This is *not* what the certified facts declare. But

assuming the facts to be as counsel here states, what had the applicant to "excuse?"

We submit that the use of the word "excuse" is wholly unwarranted in this connection. And this goes to the very essence of the Question; for what is implied in it is that an applicant for patent is under obligation to give excuses if he avails himself of a *large part* of the time allowed him by law for preparing and filing his response to the official actions, though he never has gone beyond the statutory limit.

After the illuminating decision of this Court in the *Telephone Case*, there is no need that we should undertake to expose the fallacy which underlies this implication of Question 2. But we call attention to the fact that *by the terms of the Statute itself* (Sec. 4894, as amended, quoted in defendant's brief, p. 4) the applicant is not required to give excuse (or show reason) for delay until the allotted period of a year from the date of the official action has elapsed. And furthermore, when "such delay" has occurred as demands a sufficient excuse from the applicant, the Statute requires that the excuse shall be made to *the Commissioner of Patents* (not to the Courts) and makes him the judge of the sufficiency thereof.

For the Statute expressly provides that upon failure of an applicant to prosecute his application within one year after any action therein, it shall be regarded as abandoned, "*unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.*"

But here is a case where it appears by the certified facts that there was no "such delay" in any instance. Where then is there a shadow of foundation for the proposition that the patentee has in this case lost any rights, or is liable to any penalty?

4. Referring to the last paragraph of page 6 of brief for defendants, we most assuredly do stand on the proposition that a patentee, who has prosecuted his application "*strictly as required by the Statutes and rules of the Patent Office*" (*Chapman v. Wintroath*) is not under obligation, in suing for relief in a court of equity, to give excuses for availing himself of so much of the time allowed him by law as he saw fit to take.

But we go further and say that if a new rule is to be adopted, and a radically new departure in equity procedure in this regard is to prevail hereafter, then, in all fairness the new rule should not be made retroactive. For the effect in that case would be to destroy the rights of patentees who have complied strictly with the provisions of the Statute as interpreted by the latest decisions of this Court.

And specifically, in the present case, "the absence of any other excuse for lapse of time between the Patent Office actions and responses thereto than that the applicant was exercising a statutory right," is not a proof that no valid "excuse" existed, but is amply accounted for by the fact that plaintiff was not required by any law, rule of equity, precedent, or judicial authority, to produce it.

5. Counsel for defendent-appellant have deemed it wise and prudent to take the ground in this Court that they are not asking that the patent be declared invalid because of the "long pendency in the Patent Office" of the application on which it was granted, but only that plaintiff be deprived of the right to *equitable relief*, and be remitted to its action at law for recovery of damages. But to this suggestion also the decision of this Court in *Chapman v. Wintroath* gives the full

answer. For it is there decided that, in a case like the present, the patentee's rights "may not be denied *or diminished,*" even though the delay was prejudicial (which is not the case here) to public or private interests.

Counsel's underlying thought in this part of their brief is apparently along the same lines as that with which this Court was dealing in the following passage from its decision in the *Telephone Case* (*supra*):

> "Counsel seem to argue that one who has made an invention, and thereupon applies for a patent therefor, occupies, as it were, the position of a *quasi* trustee for the public; that he is under a sort of moral obligation to see that the public acquires the right to the free use of that invention as soon as is conveniently possible. *We dissent entirely from the thought thus urged*" (ital. ours).

6. In regard to the case of *Abraham v. Ordway* (Dft's. brief p. 8) it suffices to say that there is no "undue delay" in a case where the time limit is fixed by law, and the party has acted *within that limit.*

7. In *Woodbridge v. The United States* (263 U. S. 50) cited by counsel for defendant on page 11 of their brief, the facts were of the most extraordinary and reprehensible sort. Beginning in the year 1852, Woodbridge pursued a course of evasion, deception and trickery, extending over a period of 28 years, before his application for patent was finally refused by the Court of Appeals of the District of Columbia in 1880. Then by special Act of Congress he was permitted to take his case into the Court of Claims, whence it came finally into this Court.

To begin with, Woodbridge by deceit and duplicity had his application kept in the secret archives of the Patent Office for *nine and a half years,* the limit fixed by law being *one year.* And in that initial procedure we have a fair sample of his conduct throughout. Hence, when this Court announced its condemnation of "any practice by the inventor and applicant through which he deliberately and without excuse postpones beyond the date of the actual invention the beginning of the term of his monopoly," etc., it is plain that the Court was speaking of "any practice" contrary to the intent and purpose of the statute. That language cannot be taken to apply to practices that were in strict conformity to the terms of the statute.

To give to the language just quoted (and which is more fully quoted in defendant-appellant's brief) such meaning as counsel for defendant-appellant would evidently have it convey, would impute to this Court an intention by its decision in the *Woodbridge Case,* to overrule the doctrine of the *Telephone Case* and the case of *Chapman v. Wintroath,* and to establish a new doctrine that would have the effect of diminishing, if not destroying, statutory rights of inventors. This latter is of course unthinkable; and we feel warranted in assuming that had this Court been minded to overrule any doctrine of previously adjudicated cases, it would have proceeded to do so by direct pronouncement.

8. The rule that courts of equity will not lend their aid to the enforcement of statutory rights where the conduct of the complainant in regard thereto has been inequitable or unconscionable, is without pertinence here; for the Statement of facts imputes to this pat-

entee no inequitable or unconscionable conduct of any sort whatever.

Furthermore, the question here is not one of *jurisdiction;* for the jurisdiction of courts of equity in suits for the infringement of letters patent arises as an incident to the right of the patentee to relief by way of injunction, as we have noted above. An action for infringement continues to be in its nature an action *in tort,* though brought on the equity side of the Court; and there is obviously no connection whatever between the conduct of an applicant before the Patent Office, and the ground of equitable jurisdiction over a suit for the infringement of the patent ultimately granted upon his application.

On the other hand, the action being for a trespass and a wrongful appropriation of rights of property vested by the grant of the Government, we have here presented to our view the spectacle (more ludicrous than edifying) of one in the position of an adjudged trespasser seeking to escape with the spoils of his depredations in his own hands by raising the cry that plaintiff's hands are not clean! There is no need for comment.

CONCLUSION.

The two certified Questions resolve themselves, the one into the simple question whether there was an abuse of discretion by the Patent Office in entertaining a divisional application upon subject matter of a twice-rejected and cancelled claim of a pending application, and the other into the equally simple question whether a patentee should suffer loss or diminution of rights under his grant solely because of long pendency of his application attributable in some measure to the ex-

ercise on his part of his statutory privilege in respect to the time allowed for filing responses to Patent Office actions.

We respectfully submit that both the certified Questions should be answered in the negative.

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CLARENCE S. WALKER,
REEVE LEWIS,
Counsel for Packard Motor Car Co. et al.

April 5, 1927.

E. P. COWLES.

MOTOR VEHICLE.

APPLICATION FILED AUG. 6, 1912.

1,103,567.

Patented July 14, 1914.

3 SHEETS—SHEET 1.

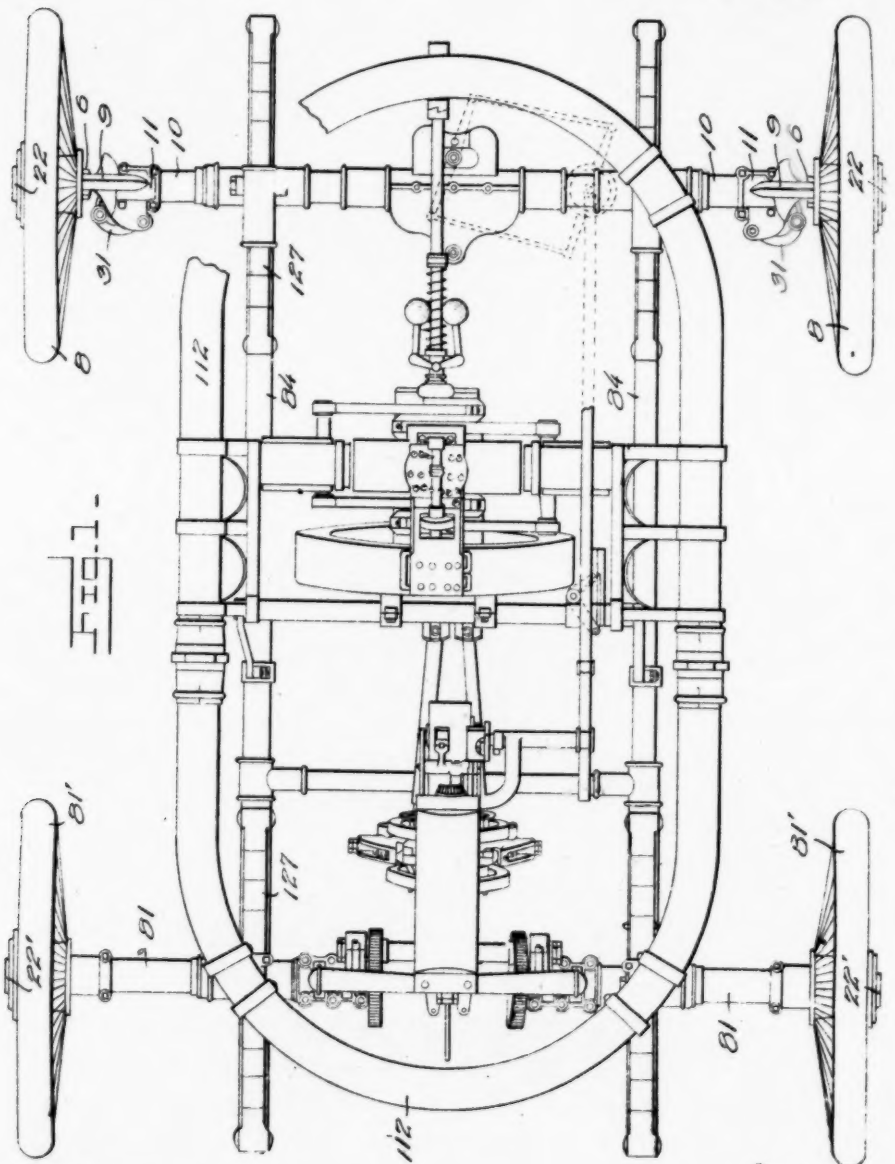

Fig. 1.

Witnesses

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1,103,567
Cowles

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3 SHEETS-SHEET 2.

Fig. 2.

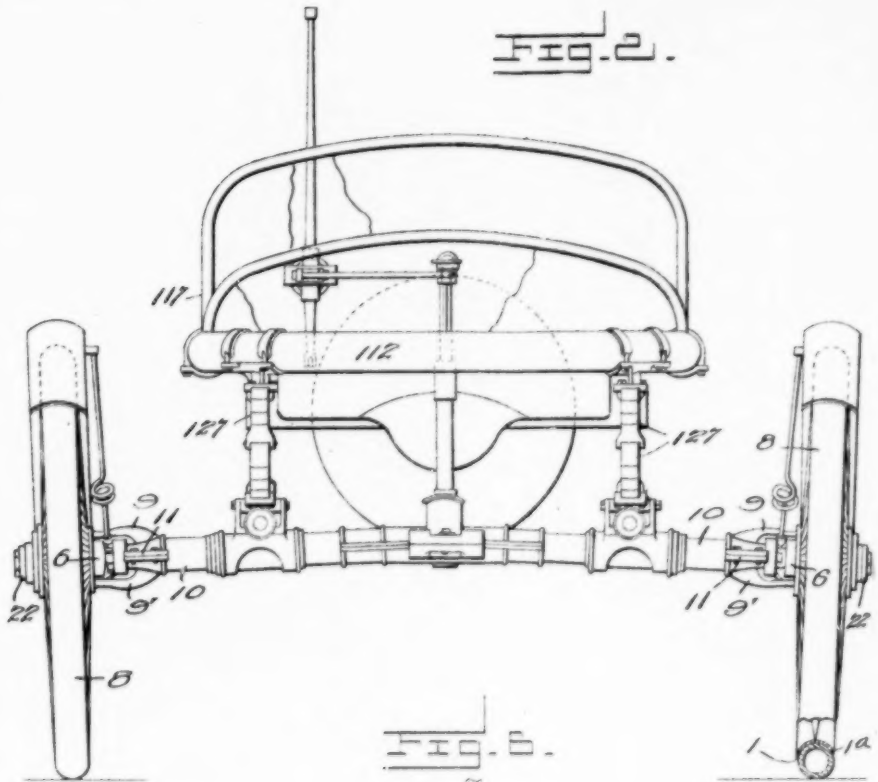
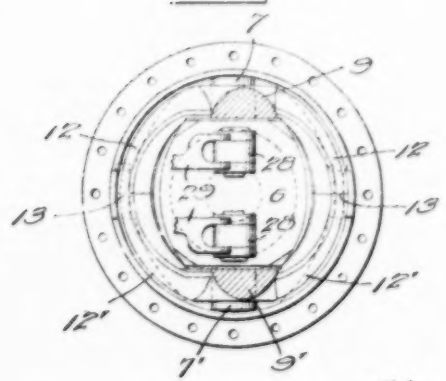


Fig. 6.



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3 SHEETS—SHEET 3.

Fig. 3.

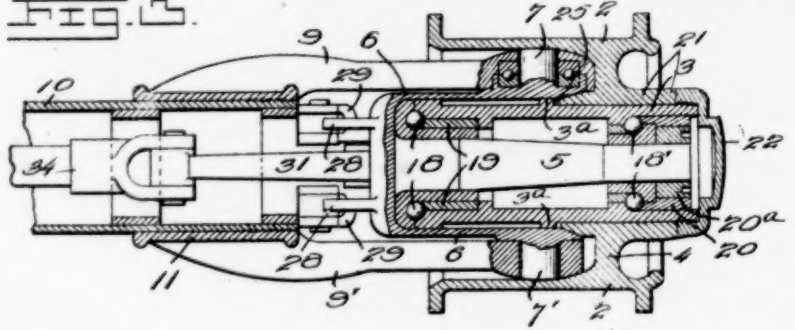


Fig. 4.

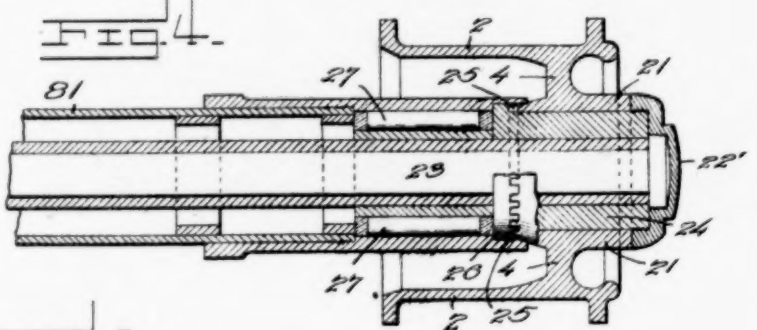
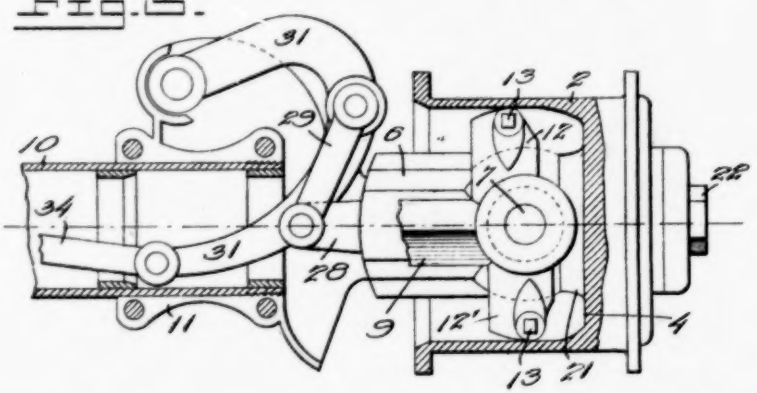


Fig. 5.



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UNITED STATES PATENT OFFICE.

EDWARD P. COWLES, OF SPARTA, MICHIGAN, ASSIGNOR BY MESNE ASSIGNMENTS, TO PACKARD MOTOR CAR COMPANY, OF DETROIT, MICHIGAN, A CORPORATION OF MICHIGAN.

MOTOR-VEHICLE.

1,103,567. Specification of Letters Patent. Patented July 14, 1914.

Original application filed September 6, 1901, Serial No. 74,497. Divided and this application filed August 6, 1912. Serial No. 713,850.

To all whom it may concern:

Be it known that I, EDWARD P. COWLES, a citizen of the United States, residing at Sparta, in the county of Kent and State of Michigan, have invented certain new and useful Improvements in Motor-Vehicles, of which the following is a specification.

This application is a division of my application Serial No. 74,497, filed September 6, 1901.

My present invention relates to improvements in motor vehicles and particularly to the running gear and steering mechanism of such vehicles.

An object of the invention is to provide a light and strong steering hub the pivotal supports of which are arranged in the revolving plane of the wheel.

Another object is to provide front and rear wheel hubs so constructed as to permit of a convenient and quick interchange of wheels or the substitution of a spare wheel for a disabled one.

With these and other objects in view, the invention consists in the construction and arrangement of parts described in the following specification, reference being had to the accompanying drawings, in which,

Figure 1 is a plan view, partly broken away, of a motor vehicle in which power is applied to the rear wheels only; Fig. 2 is a view of the front end of said vehicle, partly broken away; Fig. 3 is a vertical section through one of the steering wheel hubs and a portion of the axle; Fig. 4 is a similar view through one of the driving hubs; Fig. 5 is a view showing the steering hub illustrated in Fig. 3, partly in section, a portion of the shaft in section, and the connecting mechanism in plan; and Fig. 6 is an inner end view of the hub shown in Fig. 5.

Like parts are identified by the same reference numerals throughout the several views.

In the drawings there is illustrated a motor vehicle comprising a suitable body 117 on frame 112 supported on springs 127 on front axle 10 and rear axle 81. The axles are "cambered" or arched and are connected by reach bars 84 and supported on front steering wheels 8 and rear driving wheels 81.

The steering wheels illustrated in the drawings are of that form or type in which the main axle or wheel support is fixed and the wheel is adapted to turn, to guide the vehicle, on joints or "steering knuckles" arranged at or near the central revolving plane of the wheel. This form of steering knuckle with the type of bearings hereinafter described and the slight camber given to the axles or steering spindles, makes a very strong construction of comparatively light weight.

The rear wheels of an automobile by reason of their function of both driving and carrying the most weight are much more subject to wear and liable to be disabled than the front wheels, and it often happens that a rear wheel tire which has become so much worn that it would soon be useless on a driving wheel would last indefinitely on a front or steering wheel. It is a great advantage therefore to have steering and driving wheels interchangeable. I accomplish this desirable end by making all of the wheel hubs substantially similar, and by providing hub receiving members for the front steering axle and the rear driving axle respectively, with parts of similar exterior form, so that the wheels may be removably mounted interchangeably on the front and rear axles.

Referring to the drawings, it will be seen that the wheel hubs for the front and rear axles are similar, being shown as composed of a hollow cylinder 2 adapted to receive the wheel spokes, which can be of wire, as shown, or of any other suitable material, and a boss or part 21 connected to the cylinder part 2 by a web 4. This boss or part 21 of the wheel hub is bored out the same on all of the wheels of the vehicle so that it will interchangeably fit upon the hub receiving members of both axles, as hereinafter more fully described.

The hub receiving member for the front or steering axle 10 is shown in Fig. 3 in the form of a cylinder or sleeve 3 rotatably mounted on the spindle 5 and is arranged for steering and not for driving. Said sleeve has an external bearing surface adapted to receive the wheel hub as above suggested, and it is also formed with projections 3ª approximately midway of its length. Each of the wheel hubs also has parts such as teeth or projections 25 formed as shown on the boss or part 21 adjacent the middle

part of the hub to fit the projections 3^a on the hub receiving member.

The hub receiving member for the rear or driving axle 81 is shown in Fig. 4 in the form of a spool or cylinder 24, and is arranged for driving and not for steering, being suitably connected with a driving shaft 23 rotatably arranged within said axle 81. The driving shaft or axle 23 may as shown have its outer end enlarged by this spool or cylinder 24 and the exterior thereof is accurately the same as the external bearing surface of the hub receiving member of the front axle, so that the boss 21 of any wheel will fit either the cylinder 3 or the spool 24. The rotating motion of the driving axle 23 may be transmitted to the wheel hub by a feather or key, or any other suitable means, but I prefer to provide the inner end of the spool 24 adjacent the roller bearings 27 with a flange or shoulder 26 which is provided on its outer face with a series of teeth or projections similar to the teeth or projections 3^a on the cylinder 3, adapted to engage with the teeth or projections 25 on the boss 21 of the hub, and which are engaged by the teeth 3^a when the hub is applied to the steering axle.

A cap nut 22 for the front axle and a similar nut 22′ for the rear axle, hold the wheels on the hub receiving members with their teeth in engagement with the teeth on the cylinder 3 and the boss 24, respectively, thus retaining the detachable hubs firmly in place. By simply removing the nuts 22, 22′ the wheels can be interchanged or in case of extended journeys an extra wheel carried on the carriage can be quickly and conveniently put on to replace a disabled one, without disturbing the ball or roller bearings in any way.

The hub receiving member on the front axle hereinbefore described, is adapted to any kind of bearing, but I preferably use a combined ball and plain bearing, as shown particularly in Fig. 3. The ball bearings 18, 18′ are of the usual form, except that the inner bearing is larger than the outer to take care of the greater leverage at that point and to fit the larger circumference of the stepped axle journal or spindle 5. The cylinder 3 of the hub has a bronze ring or sleeve 19 fitted therein near its inner end, which sleeve bears against the surface of the axle 5 or the ball race sleeve which surrounds the axle. A jam nut 20^a retains both bearings in place and thereby holds the hub receiving member on the axle. The cylinder 3 extends beyond the end of the spindle 5 and thus the jam nut 20^a is arranged wholly within the end of the cylinder. About the ball race 18′ and the jam nut is fitted another bronze ring 20 which contacts with the inner surface of the outer end of the cylinder 3. The plain bearings ordinarily are inoperative but under great strains they assist the ball bearings and when either or both ball bearings are disabled the plain bearings will do all the work. The ring 20 and the jam nut 20^a also effectually close the outer end of the cylinder to prevent dirt getting into the bearings when changing outer hubs 2 as will be hereinafter described.

Referring particularly to Fig. 3 of the drawings, the steering spindle or axle journal 5 has a base portion 6, which is formed in the cup shape shown, extending entirely around the axle and into the hub between the two cylinders 2, 3. At its free end this cup shaped member is provided with two short trunnions 7, 7′, arranged diametrically opposite each other and in the same vertical plane, their axes being in or near the central plane of rotation of the wheel 8. The said trunnions 7, 7′, extend into and have bearings in eyes formed in the upper and lower arms or branches 9, 9′, of a fork which is attached to the end of the stationary or fixed axle 10 by a divided socket 11. It is obvious that by this construction the wheel 8, while being held rigidly upright is free to turn laterally on a nearly vertical axis which lies approximately in the central plane of rotation of the wheel, and that the tendency of the wheel to be deflected from its proper course by contact with obstructions is reduced to a minimum. By making axle 10 "arched" or "cambered" the trunnions or spindles 5 are arranged in planes at slight angles to the horizontal and the revolving planes of the wheels "stand out" more nearly radial to the usual curved section of the road bed. Since, as will be hereinafter described in detail, I place the larger and stronger of the bearings of the steering wheels inwardly of their revolving planes, this arched or cambered construction brings the tread of the wheel at the point of contact with the ground approximately in vertical alinement with these larger bearings.

The forks 9, 9′, are provided at their free ends with arms 12, 12′, respectively, which extend about the cup shaped portion 6 of the axle and are bolted together at 13 where they meet in the central horizontal plane of the axle. By this arrangement the fork can be made very light and have abundance of strength.

The above construction makes a strong steering knuckle inside of the wheel hub with a sufficiently long pivot to give the wheel stability and to make the steering knuckle very compact and light, without materially increasing the diameter of the hub over that ordinarily employed. This improved form of hub is also of advantage in that the roller bearing 27 of the driving axle can be extended inside the hub of the driving wheel well toward the center thereof

thus relieving the driving axle 23 of much strain in carrying the weight of the vehicle.

It will be understood that the axle journal or trunnion 5 may be oscillated by any suitable steering mechanism which may be connected to arms 28 or other means provided for that purpose. In Fig. 5 I have illustrated a steering mechanism which comprises link 34, lever 31 and links 29. For further description of this operating mechanism and of the other parts of the vehicle shown but not claimed herein, reference may be had to my co-pending application No. 74,497.

Having thus described my invention, what I claim and desire to secure by Letters-Patent is:

1. In a motor vehicle, the combination with the front axle and the spindle pivoted thereto, of a wheel on said spindle, two independent bearings interposed between said spindle and the hub of said wheel adjacent the ends of the spindle, said bearings being of different sizes, the larger being mounted at the base end of the spindle, and one of said bearings being located approximately in vertical alinement with the point of contact of the tread of said wheel with the ground while the other of said bearings is located out of line therewith, and a single adjusting means for retaining both bearings in position.

2. In a motor vehicle, the combination with the front axle, the spindle pivoted thereto to swing in a plane at a slight angle to the horizontal, a large bearing mounted at the base end of said spindle, and a smaller bearing mounted at the outer end of said spindle, of a wheel having a hub mounted on said bearings, the rim of the wheel being so constructed and located relative to the hub, and the spindle being so inclined, that the tread of the wheel at the point of contact with the ground is approximately vertically in line with one, and out of line with the other, of said bearings.

3. In a motor vehicle, the combination with the front axle, the spindle pivoted thereto to swing in a plane at a slight angle to the horizontal, a large bearing mounted at the base end of said spindle, and a smaller bearing mounted at the outer end of said spindle, of a wheel having a hub mounted on said bearings, the rim of the wheel being so constructed and located relative to the hub, and the spindle being so inclined, that the tread of the wheel at the point of contact with the ground is approximately vertically in line with the larger of said bearings.

4. In a motor vehicle, the combination with the front axle, the stepped spindle pivoted thereto, a large bearing mounted at the base end of said spindle, and a smaller bearing mounted at the outer end of said spindle, of a wheel having a hub mounted on said bearings and inclined so that the point of contact of the tread thereof with the ground is approximately vertically in line with the inner and larger of said bearings.

5. In a motor vehicle, the combination with a stationary axle, of a wheel having a hub formed of two concentric tubular members detachably connected together, the spokes of the wheel being attached directly only to the outer of said members and the inner hub member engaging suitable bearings, whereby the wheel and outer hub member may be removed without moving or affecting the said bearings, vertical trunnions supported from the axle and arranged between said concentric members of the hub, and means for adjusting the wheel about the axis of said trunnions.

6. In a motor vehicle, the combination with the front axle and the spindle pivoted thereto, of a wheel on said spindle, two independent bearings interposed between said spindle and the hub of said wheel adjacent the ends of the spindle, and one of said bearings being located approximately in vertical alinement with the point of contact of the tread of the wheel with the ground, and a single adjusting means for retaining both bearings in position.

7. In a motor vehicle, the combination with a front and a rear stationary axle, of a steering spindle pivoted at the end of the front axle, a hub-receiving member surrounding and freely rotatable upon said spindle, a driven hub-receiving member at the end of said rear axle, and wheels having hubs adapted to be removably secured, interchangeably, to said hub receiving members.

8. In a motor vehicle, the combination with a front and a rear stationary axle, of a steering spindle pivoted at the end of the front axle, a hub-receiving member surrounding and freely rotatable upon said spindle and having teeth or projections, a driven hub-receiving member at the end of said rear axle and having teeth or projections, and wheels having hubs adapted to be removably secured, interchangeably, to said hub receiving members, and having teeth or projections adapted to fit the teeth or projections on said hub-receiving members.

9. In a motor vehicle, the combination with the front and rear stationary axles, of steering spindles pivoted at the ends of the front axle, hub receiving members surrounding and rotatably mounted on said spindles, a driving shaft rotatably arranged within said rear stationary axle, hub receiving members at the ends of said rear axle and connected to be driven by said driving shaft, and wheels having hubs adapted to be

removably secured, interchangeably, to said hub receiving members.

10. In a motor vehicle, the combination with a front and a rear stationary axle, of a steering spindle pivoted at the end of the front axle, a hub receiving member surrounding said spindle, anti-friction bearings between the member and spindle, a driven hub-receiving member at the end of said rear axle, anti-friction supporting bearings for said rear stationary axle, and wheels having hubs adapted to interchangeably fit on said hub receiving members and readily removable therefrom without removing or exposing said anti-friction bearings.

11. In a motor vehicle, the combination with the front and rear stationary axles, of steering spindles pivoted at the ends of the front axle, hub-receiving members surrounding said spindles, anti-friction bearings between the members and spindles, a driving shaft arranged within said rear stationary axle, hub-receiving members at the ends of said rear axle and connected to be driven by said driving shaft, anti-friction supporting bearings for said rear stationary axle, and wheels having hubs adapted to interchangeably fit on said hub receiving members and readily removable therefrom without removing or exposing said anti-friction bearings.

12. In a motor vehicle, the combination with an axle spindle having a roller bearing including a race mounted on the axle, of a hub receiving member mounted on said roller bearing, a nut on the axle for retaining said race in position, means coaxial with said axle and engaging the inner surface of said hub receiving member for excluding dirt from said bearing, a wheel having a hub removably mounted on said hub receiving member, and means removable without disturbing said nut or removing said dirt excluding means from the hub receiving member, for retaining said wheel on the hub receiving member.

13. In a motor vehicle, the combination with an axle spindle having a roller bearing including a race mounted on the axle, of a hub receiving member mounted on said roller bearing, a nut on the axle for retaining said race in position, means coaxial with said axle and engaging the inner surface of said hub receiving member for excluding dirt from said bearing, a wheel having a hub removably mounted on said hub receiving member, and means, removable without disturbing said nut or removing said dirt excluding means from the hub receiving member for retaining said wheel on the hub receiving member, said wheel retaining means forming a closure for the outer end of said wheel hub.

14. In a motor vehicle, the combination with an axle and a steering spindle pivoted thereto, of a hub receiving member rotatably mounted on said spindle and extending beyond the end thereof, means wholly within said member for retaining said member on the spindle, a wheel having a hub adapted to be fitted upon and readily removed from said member, and means surrounding the extended end of said member for retaining said wheel thereon.

15. In a motor vehicle, the combination with an axle, of a hub receiving member rotatably mounted thereon and extending beyond the end thereof, said hub receiving member having an external bearing surface for a hub and having teeth or projections approximately midway of its length, means wholly within said member for retaining the member on the axle, a wheel hub removably mounted on said hub receiving member and bearing on said external bearing surface, said hub also having parts adjacent its middle adapted to fit said teeth or projections, and means adapted to retain the hub on the member with said teeth or projections in engagement with said parts.

16. In a motor vehicle, in combination, stationary front and rear axles, steering spindles pivoted to the front axle, hub receiving members surrounding said spindles, roller bearings between said members and spindles, a driving shaft within said rear axle, hub receiving members having driving connection with said driving shaft, roller bearings at the outer ends of the stationary rear axle through which the latter is supported by said hub receiving members, wheels having hubs adapted to interchangeably fit said hub receiving members and adapted to be fitted upon and readily removed from said members without disturbing the bearings, and means for rigidly and removably securing said wheels to said hub receiving members.

17. In a motor vehicle, in combination, stationary front and rear axles, steering spindles pivoted to the front axle, hub receiving members surrounding said spindles, roller bearings between said members and spindles, a driving shaft within said rear axle, hub receiving members having driving connection with said driving shaft, roller bearings at the outer ends of the stationary rear axle through which the latter is supported by said hub receiving members, wheels having hubs adapted to interchangeably fit said hub receiving members and adapted to be fitted upon and readily removed from said members without disturbing the bearings, and means, for each of said axles, secured to said hub receiving members, adapted to engage the wheel hubs to removably secure said wheels to said hub receiving members.

18. In a motor vehicle, in combination, stationary front and rear axles, steering

spindles pivoted to the front axle, hub receiving members surrounding said spindles and having teeth or projections, roller bearings between said members and spindles, a driving shaft within said rear axle and projecting beyond the ends thereof, roller bearings between the driving shaft and the stationary rear axle adjacent the outer ends of the latter, hub receiving members secured upon the projecting ends of the driving shaft and having teeth or projections, wheels having hubs adapted to interchangeably fit said hub receiving members and adapted to be fitted upon and readily removed from said members without disturbing the bearings, said hubs having teeth or projections adapted to fit the teeth or projections on said hub receiving members, and means for retaining the hubs on the hub receiving members with the teeth or projections in inter-engagement.

In testimony whereof I affix my signature in presence of two witnesses.

EDWARD P. COWLES.

Witnesses:
BERT BEST,
IVAN L. SMITH.

SUPREME COURT OF THE UNITED STATES

No. 285.—October Term, 1927.

Overland Motor Company, *vs.* Packard Motor Car Company and Wire Wheel Corporation of America.	On Certificate from the United States Circuit Court of Appeals for the Seventh Circuit.

[May 31, 1927.]

Mr. Chief Justice Taft delivered the opinion of the Court.

This case comes from the Circuit Court of Appeals of the Seventh Circuit, upon a certificate of two questions for our consideration and answer. Section 239 of the Judicial Code as amended by Act of January 13, 1925, ch. 229, 43 Stat. 936. The suit is one in which the Packard Motor Car Company and the Wire Wheel Corporation seek to enjoin an alleged infringement by the Overland Motor Company of the Cowles patent, No. 1,103,567, issued to Cowles on July 14, 1914, and owned by them. On August 25, 1899, Cowles filed an application which was duly granted July 13, 1900. His application disclosed the matter in suit. The Patent Office, however, required a division of claims, and he canceled all claims as well as the description and drawing in the specification that supported such claims bearing upon the subject matter of the present controversy. In that case the patent as granted covered merely the remaining claims. September 6, 1901, he filed another application, not a divisional application, disclosing and claiming, among other things, the subject matter in suit. This was pending in the Patent Office until January 21, 1913, when a patent issued for it. Certain claims made by him were repeatedly rejected by the Patent Office. Cowles complied with the requirements of section 4894, Revised Statutes, requiring an applicant to reply to the action of the Patent Office within a year, but on seven different occasions he delayed more than eleven months before filing his response to the Patent Office ruling. On

May 20, 1911, the Patent Office finally rejected the only claim remaining in the application which was directed to the subject matter in issue, holding that it was unpatentable on certain references. On May 17, 1912, Cowles canceled this finally rejected claim from his application, stating his intention to file a divisional application covering the subject matter of this claim. No such divisional application had ever been directed or suggested by the Patent Office. A patent was then (January 21, 1913) issued on other claims without any claim to the subject matter in issue. On August 6, 1912, Cowles filed an application for a patent which he stated was a division of the application filed September 6, 1901, and which disclosed and sought the claims in issue. The patent in suit was then issued on this application on July 14, 1914. During its pendency in the Patent Office, Cowles complied with the requirements of section 4894, Revised Statutes, although on one occasion he delayed over eleven months before responding to the Patent Office action. During the period from 1905 to 1912 trade journals of the United States and Great Britain published articles disclosing the subject matter in issue, and certain British patents were granted, on subjects relating to such subject matter. The publications and patents represented independent work in Great Britain, and, as a result thereof, there was actual use of the subject matter in suits abroad during the pendency of the original and divisional applications above referred to. No product embodying the subject matter of the claims in suit appeared upon the market in the United States prior to the issuing of the patent in suit. Upon these facts, the first question certified is as follows:

Did the applicant, in canceling the claim which was finally rejected on May 20, 1911, abandon such claim or estop himself from thereafter seeking it through a new application?

We do not find in the statement of facts any circumstances which can be held to be an abandonment by Cowles of his claim for which he subsequently secured this patent. On May 20, 1911, the claim was rejected on account of its non-patentability in view of certain references. On May 17, 1912, he canceled the claim, stating at the time that it was his intention to file a divisional application covering this subject matter. After he had done this, on August 6th, less than four months after the cancellation, he filed the claim as a divisional application under the earlier case, and this new

application, with the renewed claim, went to patent on July 14, 1914. We can not see why he was estopped by his failure to appeal from the final rejection. It is quite true that after such rejection the Commissioner of Patents might have refused to consider his divisional application as he made it without suggestion or consent by the Patent Office. In a qualified and limited sense a claim rejected as this was constitutes *res judicata* in favor of the Government and against the applicant. This is fully explained by Judge Morris in *In re Barratt's Appeal*, 14 App. D. C. 255, in speaking of a case presenting a similar question:

"While the rules that govern the finality and conclusiveness of adjudication at the common law do not apply, in the strict sense, to administrative or quasi-judicial action in the Executive Department of Government, yet in administrative action, as well as in judicial proceeding, it is both expedient and necessary that there should be an end of controversy. Sometimes, the element of finality is inherent in the nature of the action taken; as, for example, when letters patent have been granted, they may not be recalled, and the rights of the parties holding them again investigated. Where rights have become vested as the result of legitimate executive action, such action is necessarily final, and it is not competent thereafter for executive action to divest them, either by way of a review of the proceedings or by any new proceedings instituted with that veiw. Especially is this principle applicable to the proceedings of the Patent Office, which are so nearly akin to judicial proceedings as to be most appropriately designated as quasi-judicial."

Following then the analogy he finds that such a case as this may constitute *res judicata* in a sense, but he qualifies the statement in this important way:

"In what we have said we do not desire it to be understood that the Patent Office may not, if it thinks proper to do so, entertain and adjudicate a second application for a patent after the first application has been rejected. What we decide is, that it is not incumbent upon the office as a duty to entertain such applications, and that, if it refuses to entertain them, it has a perfect legal right so to do. An applicant is not legally aggrieved by such refusal."

This qualification is approved in the case of *In re Fay*, 15 App. D. C. 517; *In re Edison*, 30 App. D. C. 321, 323; and in *Gold* v. *Gold*, 34 App. D. C. 229.

As the Patent Office by granting the patent must be held to have waived any objection to the applications on the ground that the

claim allowed had been rejected before by that Office, there is no reason why the appellees below should not be allowed to avail themselves of the waiver. We answer the first question in the negative.

Second: The second question was as follows:

In the absence of any other excuse for lapse of time between patent applications and responses thereto than that the applicant was exercising a statutory right (R. S. section 4894 as amended setting limit of one year for response) may the bill of complaint be dismissed for want of equity because of long pendency in the Patent Office?

We think that under the decision of this Court in *United States* v. *American Bell Telephone Company*, 167 U. S. 224, and *Chapman* v. *Wintroath*, 252 U. S. 126, this question must also be answered in the negative.

By section 12 of the Act of 1861 (12 Stat. 246), it was required that all applications for patent should be completed and prepared for examination within two years after the filing of the petition, and in default thereof, were to be regarded as abandoned by the parties thereto, unless shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable. There was no provision limiting the time of the prosecution of the application in this section. By the Act of 1870 (16 Stat. 198), it was provided, in section 32, that all applications for patent should be completed and prepared for examination within two years after the filing of the petition, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they should be regarded as abandoned by the parties thereto, unless shown to the satisfaction of the Commissioner that such delay was unavoidable. This provision of the Act of 1870 was carried into the Revised Statutes as section 4894, and so the statute stood until 1897 when by 29 Stat. 693, section 4894 was amended as follows:

"All applications for patent shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown

to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

Counsel for the alleged infringer says that even with the time limit for action on the part of the applicant thus reduced to one year, it becomes easily possible for an applicant, after an action by the Patent Office upon his application, to delay for the full period of a year his response to such action, and however promptly the Patent Office may again act, he can delay another full year before replying to it, and thus, by waiting a year after each official action, (1) keep his application pending so as to enable him to withhold, indefinitely, his invention from the public, (2) add claims to his application covering the independent intervening developments of others, and (3) postpone the time when the public may enjoy the free use of the invention—all contrary to sound public policy.

The answer to this argument is that the matter is entirely within the control of Congress, and in order to avoid the evil suggested, Congress may reduce the time within which one who is seeking an adjustment with the Patent Office in order to obtain a patent shall act upon receipt of notice of a decision of the Patent Office in the course of the application through that office. Congress, as we have seen by the history of the statute, reduced this time from an indefinite period in 1861 to two years in 1870, and to one year in 1897, and, as provided in the last Congress to six months. (Public Act No. 690, 69th Congress, approved March 2, 1927.)

During the pendency of the application in this case, the period allowed was one year. We do not know on what principle we could apply the equitable doctrine of abandonment by laches in a case where the measure of reasonable promptness is fixed by statute and no other ground appears by reason of which laches could be imputed to the applicant.

In *United States* v. *American Bell Telephone Company*, 167 U. S. 224, the Government brought a proceeding in equity to cancel a patent on the ground that it had been fraudulently secured, and part of the fraud of the patentee was that he had unreasonably delayed the obtaining of the patent by collusion with officials of the Department through their non-action and thus postponed the period during which the monopoly of the patent was to continue. The court found no evidence of any collusion or fraud by the of-

ficials of the Department or undue or improper influence exerted or attempted to be exerted upon them. It said that Congress had established a department with officials selected by the Government, to whom all applications for patents must be made, had prescribed the terms and conditions of such applications and entrusted the entire management of affairs of the department to those officials, that when an applicant for a patent complied with the terms and conditions prescribed and filed his application with the officers of the department, he must abide their action and could not be held to suffer or lose rights by reason of any delay on the part of those officials. The court said:

"Neither can a party pursuing a strictly legal remedy be adjudged in the wrong if he acts within the time allowed, and pursues the method prescribed by the statute. . . . Under section 4886, Revised Statutes, an inventor has two years from the time his invention is disclosed to the public within which to make his application, and unless an abandonment is shown during that time he is entitled to a patent, and the patent runs as any other patent for seventeen years from its date. He can not be deprived of this right by proof that if he had filed his application immediately after the invention the patent would have been issued two years earlier than it was, and the public, therefore would have come into possession of the free use of the invention two years sooner. The statute has given this right, and no consideration of public benefit can take it from him. His right exists because Congress has declared that it should. . . . A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural bent but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public."

The case of *Chapman* v. *Wintroath*, 252 U. S. 126, was an attempt in an interference suit to defeat a patent granted to the Chapmans on a divisional application for an improvement in deep well pumps in which the claims were the same as the claims of a patent to Wintroath, the divisional application having been made twenty months later than the date of the issue of the patent to Wintroath. It was conceded that the claims had been disclosed in the Chapman patent which had been applied for in 1909 but which had met unusual difficulties in the Patent Office and though regularly prose-

cuted as required by law and the rules of the office, was still pending without having been passed to patent in 1915 when the controversy arose. It was admitted that the invention was clearly disclosed in the parent application of the Chapmans, but it was contended that their divisional application claiming the discovery should be denied because of their delay of nearly twenty months in filing it after the publication of Wintroath's patent when they had by law only one year. It was held by the Court of Appeals of the District (*Wintroath* v. *Chapman*, 47 App. D. C. 428) that the delay of more than a year constituted equitable laches and estopped the Chapmans from making its divisional claim. That holding had rested on a previous decision by the Court of Appeals in *Rountree* v. *Sloan*, 45 App. D. C. 207. This Court held that under section 4886 of the Revised Statutes, as amended March 3, 1897, two years was granted in such a case before the right to file a divisional application had been lost. The Court based its decision that the statutory period could not be reduced by equitable considerations or those of public policy on the language which we have just quoted from Mr. Justice Brewer in his opinion in the *Telephone* case. The same doctrine is to be found in *Crown Cork & Seal Company* v. *Aluminum Company*, 108 Fed. 845, and *Columbia Motor Car Company* v. *Duerr & Company*, 184 Fed. 893.

The case of *Woodbridge* v. *United States*, 263 U. S. 50, is cited by counsel for the defendant to sustain their view that this is a case in which the doctrine of laches and abandonment may be enforced. The *Woodbridge* case was an exceptional one. Woodbridge had deliberately delayed the issue of the patent which he could have had for the asking for nine years. He had directed the Patent Office to keep the papers upon which such issue might have been granted in the secret archives of the Patent Office, there to remain for one year, a privilege which was given him under the law as it then existed. He failed after the one year to apply for the patent for the reason, because as he avowed in subsequent application, he wished thereby to postpone the period of its monopoly until a national emergency might arise in which his invention, which was for rifling cannon, should be more in demand than it then was. He was denied a patent for failure to comply with the statute. Subsequently he secured special legislation imposing the condition that he should be granted the patent, provided the court should

first be satisfied that he had not forfeited or abandoned his right to a patent by publication, delay, laches or otherwise. This Court held that the delay of nine years for the avowed purpose of postponing the period of the monopoly was laches and a breach of the condition upon which he might avail himself of the special congressional privilege granted him. Such a case has certainly no application here. The answer to the question should be in the negative.

A true copy.

Test:

Clerk, Supreme Court, U. S.